Supreme Court, U. S.
FILED
FEB 22 1979
MICHAEL RODAK, JR., CLERK

IN THE SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1978

NO. 78-1304

AMERICAN SEATING COMPANY,
Petitioner,
v.
NATIONAL SEATING COMPANY
Respondent.

APPENDIX

PRICE, HENEVELD, HUIZENGA & COOPER
Attorneys for Petitioner
By: Lloyd A. Heneveld
BUSINESS ADDRESS:
P. O. Box 2567
Grand Rapids, Michigan 49501

mentioned above—might have had a special place in her heart or mind for Kodak. It is difficult to know how defendant now imagines there is merit in complaining about the excused juror or the other attendant events. See *United States v. Houlihan*, 332 F.2d 8, 13 (2d Cir.), cert. denied, 379 U.S. 828, 85 S.Ct. 56, 13 L.Ed.2d 37 (1964); *United States v. Pacente*, 503 F.2d 543 (7th Cir.), cert. denied, 419 U.S. 1048, 95 S.Ct. 623, 42 L.Ed.2d 642 (1974). See also *United States v. Rodriguez*, 545 F.2d 829 (2d Cir. 1976), cert. denied, 434 U.S. 819, 98 S.Ct. 58, 54 L.Ed.2d 74 (1977); *United States v. Diggs*, 173 U.S.App.D.C. 95, 522 F.2d 1310 (1975), cert. denied, *Floyd v. U. S.*, 429 U.S. 852, 97 S.Ct. 144, 50 L.Ed.2d 127 (1977); *United States v. Maxwell*, 383 F.2d 437, 443 (2d Cir. 1967), cert. denied, 389 U.S. 1057, 88 S.Ct. 809, 19 L.Ed.2d 856 (1968); *United States v. Woodner*, 317 F.2d 649 (2d Cir.), cert. denied, 375 U.S. 903, 84 S.Ct. 192, 11 L.Ed.2d 144 (1963).

In these circumstances, with all deference to distinguished counsel, it may be that this bare assertion of fatal error at this time in this civil case by this party is unlikely to be remembered as an ornament in the judicial process.

Defendant's motions are in all respect denied.

It is so ordered.

AMERICAN SEATING COMPANY, Plaintiff,

v.

NATIONAL SEATING COMPANY, Defendant.

Civ. A. No. C75-63A.

United States District Court, N. D. Ohio, E. D.

Sept. 30, 1976.

Action was instituted on complaint for alleged patent infringement and on counterclaim for alleged noninfringement and invalidity. The District Court, Contie, J., held that claims 1-6 of patent No. 3,729,226 relating to a multiple passenger transit vehicle chair comprised of a frame with an aisle side and a wall side and a single pedestal for support were invalid as anticipated by prior art, as obvious to those skilled in art at time of invention and, if based in part or in whole upon inherent safety factors, as failing to particularly describe that which is claimed therein.

Judgment for defendant.

Judgment affirmed, Cir., —— F.2d ——.

1. Patents ⇐328(2)

Claims 1-6 of patent No. 3,729,226 relating to a multiple passenger transit vehicle chair comprised of a frame with an aisle side and a wall side and a single pedestal for support was invalid as anticipated by prior art, as obvious to those skilled in art at time it was invalid, and as failing to particularly describe that which was claimed to be invented. 35 U.S.C.A. §§ 102, 103, 112.

2. Patents ⇐72(1)

Patent on product was subject to being invalidated and anticipated by prior art where it was equivalent to prior patented product in that it performed substantially same function in substantially same manner. 35 U.S.C.A. § 102.

3. Patents ⇐75, 80

Prior uses and sales of product that were not experimental but were basically designed to test commercial market and to promote product were "public uses" and were such as to invalidate patent on product when anticipated by prior art. 35 U.S.C.A. § 102.

4. Patents ⇐18

Prior art patents may be combined to determine issue of obviousness. 35 U.S.C.A. § 103.

5. Patents ⇐18

In considering issue of obviousness, scope and content of prior art are to be determined, differences between prior art and claims at issue are to be ascertained, and level of ordinary skill in pertinent art resolved. 35 U.S.C.A. § 103.

6. Patents ⇐18

Patent on product was subject to being invalidated for obviousness where product was the functional equivalent of prior patented product, did not function in any new or different mode, and did not provide any new or different result. 35 U.S.C.A. § 103.

7. Patents ⇐18

Obviousness in view of prior art is established where there is nothing in record which indicates any new or unexpected cooperative result in patent in issue and that there is, therefore, no synergistic result produced by patent. 35 U.S.C.A. § 103.

8. Patents ⇐26(1¼)

A combination which simply rearranges old elements with each performing same function it has been known to perform is not patentable. 35 U.S.C.A. § 103.

9. Patents ⇐112.1

Where prior art cited and applied by examiner during course of prosecution of patent in suit was not best prior art, presumption of validity was weakened, as opposed to strengthened. 35 U.S.C.A. § 103.

10. Patents ⇐118.5

Consideration of safety factors was inappropriate as a justification for patentability of invention relating to a multiple passenger transit vehicle chair in that asserted inherent safety features of design necessarily related to such elements as tensile strength, gauge, size, shape, and type of material used in upright column and foot, elements as to which invention was silent. 35 U.S.C.A. § 112.

11. Patents ⇐118.3

If safety considerations are asserted as a basis for patentability of invention, there must be sufficient description in patent to substantiate said claims and to delineate for future inventors that area which is claimed to be within patent. 35 U.S.C.A. § 112.

12. Patents ⇐118.3

Since patent on multiple passenger transit vehicle chair was silent in regard to any feature of energy absorption or safety features, such considerations could not be considered by court in determining patentability and, if patentee based patentability on such features, patent was invalid as failing to particularly point out and distinctly claim that which it alleged was subject matter of patent. 35 U.S.C.A. § 112.

13. Patents ⇐314(2)

Issue of infringement of patented product was moot in view of finding that patent was invalid, but in the interest of judicial economy, the court would consider the evidence presented and make factual determinations on the issue of infringement.

14. Patents ⇐234

Plaintiff could not on the one hand urge a narrow construction concerning the validity of its patented product and on the other hand a broad interpretation in asserting infringement of its product by defendant.

15. Patents ⇐234

Consistent readings of the patent in issue must be utilized by the court in determining both validity and infringement.

16. Patents ⇐157(1), 162

A patentee can be his own lexicographer and, thus, can utilize his own terms and define them for use in his patent as long as he remains consistent with his position.

17. Patents ⇐165(3)

General and normal definition of term "transit" as used by plaintiff in its patent for a multiple passenger transit vehicle chair would apply to both intercity and intracity bus seating field and, therefore, would include both stationary back and recliner back seats in determining whether patent was infringed by any other product.

18. Patents ⇐236(2)

If patent for a multiple passenger transit vehicle chair was valid, there would in fact be infringement by chairs manufactured by defendant, but only for those chairs on models in which pedestals were placed at a center or intermediate position, not for those models in which pedestals were placed in an aisle position.

F. Rush McKnight, Calfee, Halter & Griswold, Cleveland, Ohio, Lloyd A. Heneveld, Grand Rapids, Mich., for plaintiff.

Charles B. Lyon, John W. Renner, Donnelly, Maky, Renner & Otto, Cleveland, Ohio, for defendant.

MEMORANDUM OPINION AND ORDER

CONTIE, District Judge.

The above captioned cause of action came on for trial before this Court from February 13, 1976 through February 25, 1976. The following shall constitute this Court's findings of fact and conclusions of law, pursuant to Rule 52(a) of the Federal Rules of Civil Procedure.

THE PARTIES

Plaintiff American Seating Company (hereinafter American) brings this action asserting patent infringement of its United States Letters Patent No. 3,729,226 (hereinafter '226) issued April 24, 1973, against defendant National Seating Company (hereinafter National). Defendant has answered American's complaint, alleging noninfringement and invalidity, and has counterclaimed asserting the same defenses.

Plaintiff is a Delaware corporation, having its principal place of business in Grand Rapids, Michigan. Chester J. Barecki, the inventor of the '226 Patent, is an employee of American who has been involved in the transportation field since the 1940's.

Defendant National is a subsidiary of National City Lines. National makes only recliner type inter-city passenger bus seats today, although at one time it made both intra-city and inter-city type bus seats.

PENDING MOTIONS

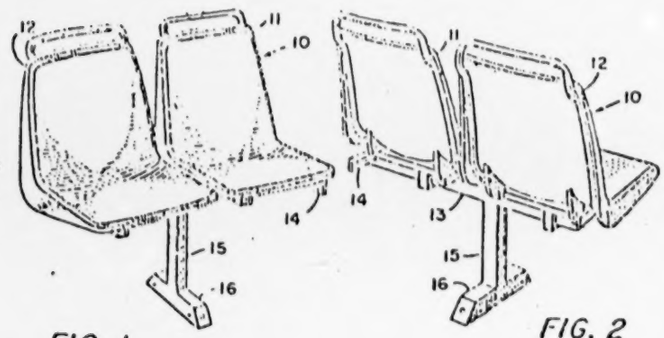
There are presently pending before this Court plaintiff's motion for payment of expenses concerning the post trial deposition of Mr. Barecki and defendant's motion to strike portions of said deposition.

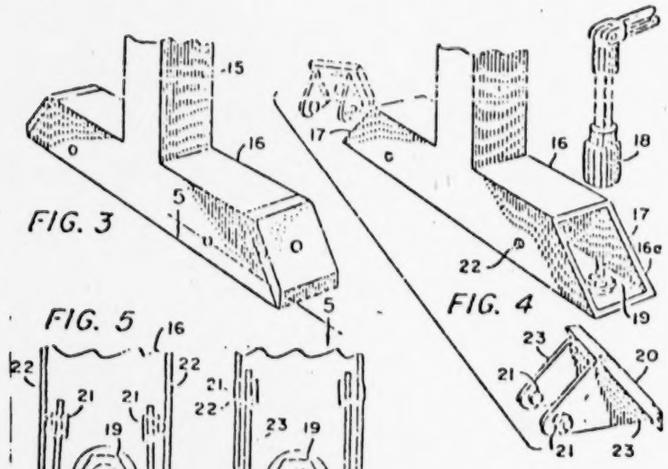
During trial it was brought out that defendant had sent the wrong model seats to plaintiff for certain tests to be performed for trial. Upon learning of this, the Court ordered defendant to supply the appropriate seats, and further allowed plaintiff to conduct tests and further depose Mr. Barecki concerning those tests. Upon consideration, the Court shall grant plaintiff's motion for an award of expenses in the amount of Three thousand, two hundred ninety-seven dollars ($3,297.00) only. The remainder of plaintiff's motion is denied.

THE '226 PATENT

The '226 Patent (see diagram, next page) was designed by Mr. Barecki around April, 1970. Said patent contains six claims, Claims 1 and 6 being independent, and Claims 2 through 5 being dependent upon Claim 1. Said claims disclose two side-by-side seats, 11 and 12, which are both mounted upon a beam 13. Said beam 13 is provided at one end with an angle iron 14 for connecting the beam to a vehicle wall. The beam 13 is supported at its center by a pedestal which includes an upright column 15. The bottom of column 15 is provided with a tubular foot 16, extending fore and aft of the vehicle. The ends of the tubular foot 16 are cut on a 45 degree bias as shown at 17 to define access openings in the tubular foot leading to the fastening bolts used to secure foot 16 to the floor. The access apertures may be selectively covered by plates 20 which are releasably retained in positions by a U-shaped spring plate 23, having lugs 21 received in apertures 22 in the foot 16.

Patented April 24, 1973 3,729,226





INVENTOR
Chester J. Barecki

BY Dawson, Tilton, Fallon and Lungmus
ATTORNEYS

It is the assertion of plaintiff that said structure provides the advantages of better clearance between seats, resulting in ease of cleaning the floor, increased leg room, increased storage space, and provides ease and safety in egress and ingress to the passengers.

The specific claims in issue of the '226 Patent read as follows:

"Claim 1

"A multiple-passenger transit vehicle chair comprising: a chair frame with an aisle side and a wall side, said frame supporting a plurality of passenger chairs side-by-side, mounting means on said wall side of said frame for securing said frame to a vehicle wall; a single pedestal cooperating with said wall to support said frame, said pedestal being spaced at an intermediate location between said wall side and said aisle side of said frame and including an upright column rigidly connected at its top to said frame; a hollow tubular foot member integral with the bottom of said column and extending forwardly and rearwardly therefrom, said foot having a generally flat bottom plate resting on the floor of said vehicle and provided with a bolt hole adjacent each end thereof to receive floor fastening bolts securing said foot to the vehicle floor at forward and rearward positions relative to said column, said tubular foot member further defining forward and rear access apertures adjacent their associated bolt holes to permit access to said fastening bolts when they are received in said bolt holes; said first and second closure means removably attached to said foot to cover said access apertures of said foot member respectively and cooperating with said hollow foot member to enclose said fastening bolts when said closures are assembled to said foot while permitting unrestricted tool access to said fastening bolts when said closures are removed.

"Claim 2

"The structure of Claim 1 wherein said column of said pedestal is located at the approximate longitudinal and transverse center of the seat portion of said frame and wherein said mounting means comprises flange means attached to said frame for securing the same to the vehicle wall.

"Claim 3

"The structure of Claim 1 wherein said tubular foot member has a rectilinear cross section with open forward and rear ends providing said access apertures, said access apertures extending at an inclination relative to the horizontal from the bottom plate of said foot member upwardly and towards said column member, thereby permitting vertical as well as side tool access.

"Claim 4

"The structure of Claim 1 wherein said frame comprises a cross beam extending longitudinally of said chair, and wherein said mounting means comprises a rail carried by said cross beam, said structure further comprising a pair of seats mounted upon said cross beam in side-by-side relation.

"Claim 5

"The structure of Claim 3 wherein said closure means comprise first and second end plates covering respectively said front and rear inclined access apertures of said hollow rectilinear foot member.

"Claim 6

"A two-passenger transit vehicle chair comprising: a chair frame with an aisle side and wall side, first and second chairs carried by said frame in side-by-side relation; mounting means securing the wall side of said frame to an upright vehicle wall; a single pedestal supporting said frame and including an upright column member connected to said frame at its approximate longitudinal midpoint and an integral hollow tubular foot member extending fore and aft of said chair from the bottom of said column member, said wall mounting means and said pedestal being the only support for said frame and said chair, said foot having a generally rectilinear cross section and having forward and rear open ends defining forward and rear access apertures, each of said open ends being inclined from the bottom of said foot upwardly and towards said column; first and second fastening bolts attaching said foot member to said floor of said vehicle at locations adjacent respectively said forward and rear access apertures, said bolts extending at least partially within said hollow foot members; and first and second cover members releasably attached to said hollow foot member to cover respectively said forward and rear access apertures, said access apertures extending from the side of an associated fastening bolt over and above the same to permit unrestricted tool access to a fastening bolt when the associated cover is removed."

PLAINTIFF'S AND DEFENDANT'S ARGUMENTS

Plaintiff asserts that its patent is valid and defendant's seat models 1059, 1060, the "Old 1070", and the "New 1070"[1] infringe the patent in suit. Plaintiff asserts that Models 1059 and 1060 were sold in 1973 and directly infringe upon the patent in suit as well as both the New and Old Model 1070 developed generally in 1973 and sold in 1974 and 1975, which also read directly upon the patent in issue.

Plaintiff further alleges that the National models mentioned above are essentially copies of the '226 Patent and further claims that National's seat design and development were copied from American's patented product.

Defendant asserts that plaintiff's patent is invalid pursuant to Title 35 U.S.C. § 102 as it was anticipated by the prior art and was obvious pursuant to Title 35 U.S.C. § 103 to one skilled in the art at the time the invention was assertedly made. Finally, defendant argues that plaintiff should be estopped from asserting infringement against defendant because of plaintiff's conduct before the Patent Examiner in failing to point out the best prior art available.

Further, defendant National asserts that the development of its seat models and foot designs were independent of any development or patent of plaintiff.

VALIDITY

[1] Upon consideration and as will be discussed below, it is the determination of this Court that the patent in suit, United States Letters Patent No. 3,729,226, is invalid as it was anticipated by prior art, was obvious to those skilled in the art at the time it was invented, and further as it fails to particularly describe that which is claimed to be invented.

The Court turns first to the issue of validity of the '226 Patent under Title 35 U.S.C. § 102. Title 35 U.S.C. § 102 reads, in pertinent part, as follows:

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . ."

This section of the Patent Law has been generally referred to as anticipation. As stated by the Sixth Circuit in the case of

1. Defendant's "Old 1070" includes a foot with a 45 degree angle cut at its ends defining an access aperture to a bolt hole for a bolt fastener. The "New 1070" includes a foot with a straight cut end and a welded flange attached thereto. Since the 1070 model thus encompasses two different foot designs, which this Court finds to be of possible consequence to a finding of infringement (see discussion below), they shall be dealt with separately.

Allied Wheel Products v. Rude, 206 F.2d 752, 760 (6th Cir. 1953):

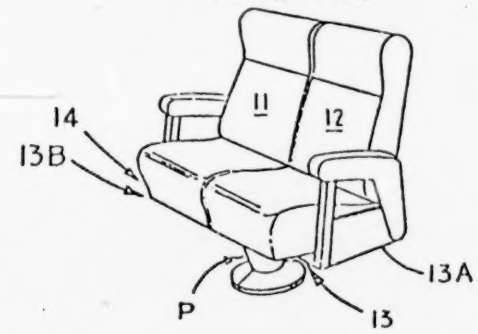
"In order to anticipate an invention, it is necessary that all the elements of the invention or their equivalents be found in one single description or structure, where they do substantially the same work in substantially the same way."

Plaintiff asserts that none of the prior art cited to the examiner nor any of that presented by defendant at trial illustrates all of the elements of the invention in one single description.

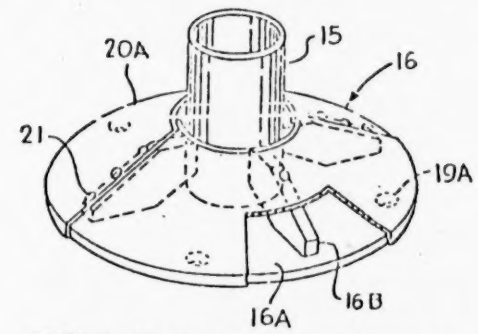
As stated by plaintiff in its brief:

"The elements of the Barecki patented chair cannot be found in any one alleged prior art reference cited by National. Not one of the alleged references including the Greyhound Tour Coach seat, the American rounded base pedestal seat, National's 1025-31 seat, National's 1039, 1040 seat, Heywood Wakefield's pedestal, Mitchell's table, Howell's sequence seating, the S. Karpen seat, and the remaining others of the 46 alleged references discloses the combination of (1) a frame supporting a plurality of chairs side-by-side; (2) a mounting means for securing the wall side to a vehicle wall; and (3) a special single pedestal specifically defined in the claims as including an upright column, and a hollow tubular foot member integral with a column. Further, none of such alleged references show such a combination with the hollow tubular foot member extending forwardly and rearwardly from the column and having a flat bottom plate with bolt holes at the ends securing the foot to the vehicle floor at the forward and rearward positions, said foot also having access apertures adjacent the bolt holes to permit access to the bolts, and said foot having closure means removably attached to the foot to cover the access apertures of the foot member and cooperating with the foot members to enclose the fastening bolts when the closures are assembled to the foot while permitting unrestricted tool access to the fastening bolts when the closures are removed." Plaintiff's Post Trial Brief filed May 3, 1976, pages 87 to 88.

However, defendant asserts that there are several seats which have been designed, manufactured and sold which anticipate the '226 Patent. The first such seat is known as the Greyhound Tour Coach Seat, (see diagram next page) manufactured, designed and sold by National to Greyhound. Said Tour Coach seat includes side-by-side recliner seats 11 and 12 supported on frame beam 13, having aisle side 13-A and wall side 13-B and mounting means 14 provided to secure the wall side of the frame to the vehicle wall. Frame 13 is also supported by a pedestal P, including a column 15 and a foot 16. Such foot 16 includes a circular bottom plate 16-A welded to the bottom of the upright column and four spaced gussets 16-B interconnecting the column 15 and the bottom plate 16-A. The bottom plate 16-A has four equally circumferentially spaced countersunk mounting holes 19-A therein to receive fasteners to secure the same to the vehicle floor. The foot 16 is selectively covered by a two-piece shroud 20, 20-A, joined by screws 21, such shroud acting to conceal the four spaced fasteners. The above described pedestal P can be positioned at the center of the seat frame for some seats or in an intermediate position between the center of the frame and the aisle side for other seats.



NATIONAL CENTER PEDESTAL
TOUR COACH SEAT (1955-6)



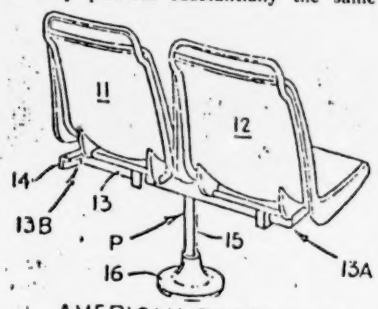
DETAIL OF NATIONAL'S PEDESTAL
FOR TOUR COACH SEAT

The Tour Coach seat was developed by National in 1955 and 1956, and was sold to Greyhound. The Court specifically finds that said seat was not experimental in nature and was, in fact, sold through regular means by defendant to Greyhound for use on a transit vehicle. Further, this Court specifically finds that the Tour Coach center pedestal seat includes all of the advantages asserted by plaintiff in its patent, including aesthetic considerations, ease in cleaning, increased leg and storage room, increased ease in maintenance, and increased ease for passenger ingress and egress.

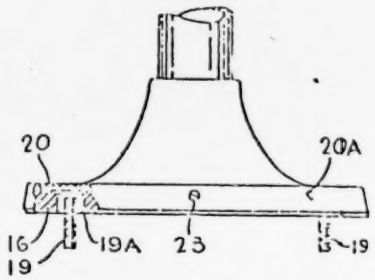
[2] This Court does not agree with plaintiff's analysis of the prior art. As stated above, the Greyhound Tour Coach seat provides for a frame supporting a plurality of chairs side-by-side and a mounting means for securing the wall-side to a vehicle wall. Further, said seat provides for a single pedestal, including an upright column. It thus appears that plaintiff's argument regarding the lack of anticipation is based upon its contention that the tubular foot of the '226 Patent is distinguishable from the round base foot of the Greyhound Tour Coach seat. It is the determination of

this Court that said assertion is untenable and an insufficient basis upon which to distinguish the prior art. The tubular foot of the '226 Patent and the round based pedestal of the Greyhound Tour Coach seat are found to be equivalents of one another as they perform substantially the same function in substantially the same manner. *Tee-Pak v. St. Regis Paper Co.*, 491 F.2d 1193 (6th Cir. 1974).

Further, this Court finds that American's 1969 round based center pedestal seat with concealed fasteners anticipates the '226 Patent in suit. (See diagram below.)



AMERICAN ROUND BASE CENTER PEDESTAL SEAT (1969)



DETAIL OF AMERICAN ROUND BASE PEDESTAL AND COVER

Such seat includes two side-by-side transit seats 11 and 12 mounted on a tubular beam 13, having an aisle-side 13–A and a wall-side 13–B. Such wall-side of the frame is provided with a flange means 14 to secure the frame to the vehicle wall. The center pedestal P is provided to support frame 13 in conjunction with the wall mount, such pedestal including an upright cylindrical tubular column 15 and a cast foot 16 extending fore and aft of such column. Such foot 16 includes a plurality of counter-sunk holes 19–A adapted to receive floor fasteners 19 to secure the pedestal to the floor. The cast foot was selectively covered by a two-piece stainless steel shroud 20, 20–A interconnected by screws 23, such shroud acting to conceal the fasteners.

The only difference between American's round based center pedestal seat and the seat disclosed in the '226 Patent consists of the use of a round based foot instead of a tubular foot. Otherwise the 1969 round based pedestal seat is identical to the seat disclosed in the 1971 patent application, as was admitted by Mr. Barecki during his testimony.

It is the determination of this Court that said center pedestal seat offers all of the advantages asserted by plaintiff to be in its '226 Patent, i. e. ease in egress and ingress, ease in cleaning, and better storage and foot space. Further, it is the determination of this Court that the evidence and testimony establishes that American's round based center pedestal seat was sold to General Motors in October of 1969 as evidenced by Defendant's Exhibit EJ and another sale of such seats was made to General Motors in May and June of 1970, as evidenced by Defendant's Exhibit EO. It is the conclusion of this Court that said seats were sent to General Motors for installation in a bus for actual demonstration purposes to the public, and that such seats were billed and paid for and were not provided for testing purposes, nor were they provided under any secrecy agreement. As was stated by the Sixth Circuit in the case of *Minnesota Mining & Manufacturing Co. v. Kent Industries, Inc.*, 409 F.2d 99, 100 (6th Cir. 1969):

"It is settled law that a single public use [citation omitted], or only a placing on

sale [citation omitted] is sufficient to invalidate a patent under 35 U.S.C. § 102(b)."

[3] This Court is convinced that the prior public uses and sales by American to General Motors were not experimental but were basically designed to test the commercial market and to promote American's product. See *Cataphote Corp. v. DeSoto Chemical Coatings, Inc.*, 235 F.Supp. 936 (N.D.Cal.1964), aff'd, 356 F.2d 24 and 358 F.2d 732 (9th Cir. 1966), cert. den., 385 U.S. 832, 87 S.Ct. 71, 17 L.Ed.2d 67 (1966). See also *Smith et al. v. Sprague*, 123 U.S. 249, 8 S.Ct. 122, 31 L.Ed. 141 (1887); *Solo Cup Co. v. Paper Machinery Corp.*, 240 F.Supp. 126 (E.D.Wis.1965), reversed in part on other grounds, 359 F.2d 754 (7th Cir. 1966); *Dunlop Co. Ltd. v. Kelsey-Hayes Co.*, 484 F.2d 407 (6th Cir. 1973).

As plaintiff has failed to illustrate any functional difference between the round based foot and that claimed in the '226 Patent, and as this Court is unable to find any, this Court finds that said feet are equivalents. It is, therefore, the determination of the Court that the American 1969 Round Base Pedestal seat anticipates the '226 Patent.

Therefore, this Court finds that both the Greyhound Tour Coach seat and the American 1969 Round Base Pedestal seat anticipate the '226 Patent in suit.

The Court next turns to the issue of obviousness under Title 35 U.S.C. § 103. Assuming, arguendo, that plaintiff's patent was not anticipated, it is the determination of this Court that said patent is invalid as it would have been obvious to one skilled in the art at the time the invention was made under Title 35 U.S.C. § 103. Said section provides:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

[4] Prior art patents may be combined pursuant to this section to determine the issue of obviousness.

"It is well settled that claims may be properly rejected on a combination of several patents taking specific features from each. It is not necessary that a complete disclosure be contained in a single reference." *Application of Bisley*, 197 F.2d 355, 362, 39 CCPA 982 (1952)

Further:

"All elements of the prior art have a bearing upon the question of invention; it being unnecessary to a finding of lack of invention that every element be found in one embodiment." *Ohmer Fare Register Co. v. Ohmer et al.*, 238 F. 182, 187 (6th Cir. 1916)

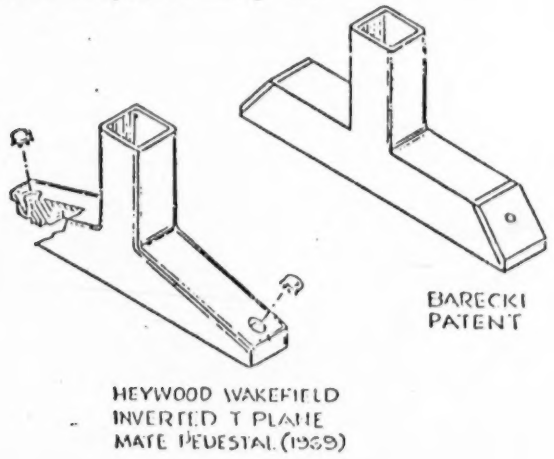
The Court must first note that plaintiff's patent is addressed to a combination of old elements. There is no question that placing two chairs side-by-side on a frame attached to a beam supported by some means was known in the prior art. There is no question that it was known in the art that transit vehicle seats could be supported by attaching one side to the wall while providing a support for the remainder of the seating arrangement. Further, there is no question that seat manufacturers skilled in the art at the time that the invention was claimed to have been made were aware of a single pedestal seat supports for seating.

Specifically, Mr. Barecki had worked on the BART (Bay Area Rapid Transit) project which used cantilevered and semi-cantilevered seats. The Steinbeck Patent 1,096,518, the Del Giudici Patent 3,480,240, the Krehbiel Patent 474,666, and the Kohler Patent 1,281,793, all prior art patents, provide for center of intermediate pedestal seats. Further, inverted T Pedestals were known in the seating art previous to the date of the invention. See the Blink Patent 198,218 and Howell sequence seating chairs. The Hozeski and Barecki Patent 3,567,281

disclosed an inverted T-type pedestal which illustrates advantages concerning maintenance reduction and concealed fasteners to avoid dirt collection. The Greyhound Tour Coach seat, the BART seats, National's 1040 leg, the plugs used in the Heywood Wakefield Plane Mate seat, and the stainless steel cover used by American on its round base center pedestal seat all illustrate the use of selectively covered floor fasteners.

It is the determination of this Court that the prior art shows the entire combination as reflected in the '226 Patent. All of the elements of the patent were old. Further, the elements used by Mr. Barecki in the '226 Patent were all present in the art directly related to transportation seating field or to furniture products field in American Seating's line.

As noted above, the only significant difference between the '226 Patent and the prior art is the structure of the support column and the foot of said patent. It is the opinion of this Court that the design of plaintiff's column and foot on the '226 Patent is obvious in light of the Heywood Wakefield inverted T Plane Mate pedestal (see diagram below). The Wakefield pedestal includes a tubular type upright to support chairs or seats and a channel shaped foot extending fore and aft therefrom. Such foot is provided with base plates at each end thereof, such base plates being provided with holes to receive floor fasteners.



Access is provided to such floor fasteners by the foot defining fore and aft inclined apertures which are selectively covered by caps held in place by spring fingers.

The evidence illustrates that this pedestal was used in a Plane Mate Mobile Lounge in November of 1969, and that such pedestal and the lounge in which they were used were publicly demonstrated in Port Washington, Pennsylvania. It further appears from the evidence received that Heywood Wakefield was selling these pedestals for large production runs as of August, 1969.

[5] The test as to obviousness has been set forth by the Supreme Court in the leading case of *Graham v. John Deere Company*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). Therein the Court stated:

"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. *Graham v.*

John Deere Company, 383 U.S. 1, 17, 86 S.Ct. 684, 694, 15 L.Ed.2d 545 (1966)

Pursuant to the test established by the Supreme Court in the *John Deere* case, this Court finds that as a matter of fact the research and development personnel of both National and American are indicative of the level of ordinary skill in the art of transit seating. Mr. Barecki, Mr. Edwards and Mr. Owens have all been involved in the transportation seating industry since the late 1940's. Further, it appears from the record that Mr. Barecki, Mr. Hogan and Mr. Hozeski have had extensive experience in the field of furniture products including theater and sequence seating. It is the determination of this Court that the experience in the general seating and furniture fields can easily be applied from one area to another.

This Court is of the determination that plaintiff's patent would have been obvious to those skilled in the art at the time the invention is claimed to have been made. The Court bases this determination upon consideration of the American round base pedestal, National Tour Coach seat, the Howell sequence seating seats, the Heywood Wakefield inverted T Plane Mate Pedestal, as well as the other prior art patents mentioned above.

The Court finds that said seats and prior art patents clearly show all of the elements claimed by plaintiff in its '226 Patent. As stated above, the seating structure itself was not new and would have been obvious to anyone skilled in the art of transit seating or seating in general. The seat support claimed in the '226 Patent is extremely basic and was identical to that in the American Round Base Pedestal seat offered for sale in 1969. The pedestal, as mentioned above, is the only part of the claimed patent that in any way adds or is claimed to have added any new element to the seating structure. Even a cursory glance at the Heywood Wakefield inverted T Plane Mate Pedestal, used in 1969, indicates an almost identical structure as that claimed by plaintiff in its patent. Plaintiff asserts that the Heywood Wakefield inverted pedestal provides for a channel at the bottom of the foot as opposed to a hollow tubular foot. The Court finds this distinction to be without merit, as the same function and use results from the Heywood Wakefield inverted T Plane Mate Pedestal as does that in the plaintiff's invention in the '226 Patent.

[6] Plaintiff contends that the pedestal of the patent in suit is distinguishable from the round base pedestal of the Tour Coach seat, as well as all other round base pedestals, and is unique in its function and advantages from round base pedestals. The Court cannot agree with this conclusion. This Court finds that the round based foot and the foot of the '226 Patent in suit are the functional equivalents of one another, and that the '226 foot does not function in any new or different mode, nor does it provide any new or different result.

As stated by the Sixth Circuit, in the case of *Philips Industries, Inc. v. State Stove and Manufacturing Company*, 522 F.2d 1137, 1141 (6th Cir. 1975):

"Given that the individual claim elements are old and disclosed in the prior art, if this device is to be patentable then there must be that 'impalpable something', *Harvey v. Levine*, 322 F.2d 481, 485 (6th Cir. 1963), in the combination itself that would render the invention unobvious. The Supreme court decisions require that patents for the combination of old elements receive special scrutiny 'with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements.' *Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152, 71 S.Ct. 127, 130, 95 L.Ed. 162 (1950). The concept of 'synergistic result,' which is 'when the whole in some way exceeds the sum of its parts,' has evolved to determine what constitutes the 'key requirement,' of patentability. *Anderson's-Black Rock v. Pavement Salvage Co., Inc.*, 396 U.S. 57, 60-61, 90 S.Ct. 305, 24 L.Ed.2d 258 (1969); *Great Atlantic & Pacific Tea Co., supra*, 340 U.S. at 152, 71 S.Ct. at 130.

"There is nothing in the record which indicates . . . any new or unex-

pected cooperative result. . . . However, both of these benefits function independently. Each element operates as well separately as it does in combination, and as in *Anderson's-Black Rock, supra*, 396 U.S. at 60, 90 S.Ct. at 307, the combination 'though perhaps a matter of great convenience, did not produce a "new or different function," *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, 58 S.Ct. 662, 664, 82 L.Ed. 1008 within the test of validity of combination patents.'"

[7] Upon consideration of the prior art cited to the Patent Office and the prior art cited to this Court in the instant case, it is the determination of this Court that there is nothing in the record which indicates any new or unexpected cooperative result in the patent in issue, and that therefore there is no synergistic result produced by the '226 Patent.

The Supreme Court has recently spoken in this area in the case of *Sakraida v. Ag Pro Inc.*, 425 U.S. 273, 96 S.Ct. 1532, 47 L.Ed.2d 784 (1976). In that decision, the Supreme Court stated:

"We cannot agree that the combination of these old elements to produce an abrupt release of water directly on the barn floor from storage tanks or pools can properly be characterized as synergistic, that is, 'result[ing] in an effect greater than the sum of the several effects taken separately.' *Anderson's-Black Rock v. Pavement Co.*, 396 U.S. 57, 61, 90 S.Ct. 305, 308, 24 L.Ed.2d 258, 261 (1969). Rather, this patent simply arranges old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations. Such combinations are not patentable under standards appropriate for a combination patent. *A & P Tea Co. v. Supermarket, etc. Co., supra; Anderson's-Black Rock v. Pavement Co., supra.*" *Sakraida, supra*, 425 U.S. at 282, 96 S.Ct. at 1537.

[8] So, too, the '226 Patent simply rearranges old elements with each performing the same function it had been known to perform. Such a combination is not patentable.

[9] It is further the opinion of this Court that the prior art cited and applied by the examiner during the course of the prosecution of the patent in suit was not the best prior art available. Said prior art did not include any showing of the overall combination claimed, a center pedestal for a two passenger transportation seats or concealed fasteners for such pedestals. It is thus the determination of this Court that since the examiner was not aware of the best prior art, the presumption of validity is weakened, as opposed to strengthened. See *Holstensson v. V-M Corporation*, 325 F.2d 109 (6th Cir. 1963); *Westinghouse Electric Corporation v. Titanium Metals Corporation of America*, 454 F.2d 515 (9th Cir. 1971), cert. den., 407 U.S. 911, 92 S.Ct. 2439, 32 L.Ed.2d 685 (1972).

[10] Plaintiff attempts to argue that the pedestal and foot in the patent in suit provide improved energy absorption characteristics and are more crash-worthy than any such pedestals or feet in the prior art. A great deal of testimony and evidence was received in regards to the safety factors asserted by plaintiff to be inherent in the '226 Patent. However, it is the determination of this Court that consideration of the safety factors is inappropriate as a justification for patentability of the '226 Patent.

The asserted inherent safety features of the seat design of the '226 Patent relate to the upright column and foot design and would necessarily relate to the tensile strength, gauge, size, shape, and type of material used in said upright column and foot. The patent in issue is silent as to any such references. In the Sixth Circuit case of *Cole v. Sears, Roebuck & Co.*, 520 F.2d 673 (6th Cir. 1975), the court therein, in dealing with an argument that the plaintiff's patent therein, Claims 7, 8, and 9, represented a novel and patentable system of placing certain slots for air induction, stated:

"If on the other hand, as plaintiff-appellant Cole contends, the air induction system through the 'slots' about the drip pan, depends for its effectiveness on the number, size and location of said slots, such features must be disclosed both as limitations upon the patent and as a means of teaching its art. 35 U.S.C. § 112 (1970). Finding no such specifics in the broadly stated elements, we hold, as we did in *Kaiser Industries Corp. v. McLouth Steel Corp.*, 400 F.2d 36 (6th Cir. 1968), cert. denied, 393 U.S. 1119, 89 S.Ct. 992, 22 L.Ed.2d 124 (1969), and *Philips Industries, Inc. v. State Stove and Mfg. Inc.*, 522 F.2d 1137, at 1140-1141 (6th Cir. 1975) that the patent is invalid for lack of particularity in the claims as required by 35 U.S.C. § 112 (1970):

"'The patent law does not require a prospective inventor to search so far in attempting to determine the scope of a patent and the areas left open for inventive inquiry. Section 112 provides that it is the claims that shall *particularly point out* and *distinctly* [emphasis in original] claim the subject matter of the patentee's invention. Certainly, terms used in the claims can gain meaning from the specifications or from the knowledge attributable to one skilled in the art. But a prospective inventor is required to go no further in attempting to determine the invention claimed and the areas foreclosed to future enterprise . . .

"'In our view of this case, the Appellants ask this Court to ignore the precision of definition required of them by the statute. As the Supreme Court noted in *Union Carbon v. Binney & Smith Co.*, 317 U.S. 228, 63 S.Ct. 165, 87 L.Ed. 232 (1942), to allow claims "so indefinite as not to give the notice required by the statute would be in direct contravention of the public interest which Congress . . . recognized and sought to protect." In that case the Court considered a product patent where the distinction from the prior art was a matter of degree. The Court rejected terms, such as, "substantially pure," "commercially uniform," and "comparatively small," that gave no standard for comparison or were so indefinite as to have no established meaning to one skilled in the art. *Kaiser Industries Corp. v. McLouth Steel Corp., supra* [400 F.2d] at 50-51.'" *Cole, supra*, at 675.

[11] It is the determination of this Court that, as in *Cole, supra*, if plaintiff is to assert safety considerations as a basis for patentability, there must be sufficient description in the patent to substantiate said claims and to delineate for future inventors that area which is claimed to be within the patent. The Court has reviewed the patent in issue and has found that it is totally silent as to any considerations of safety or advantages in regards thereto.

Title 35 U.S.C. § 112 states:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

[12] Since the '226 Patent is silent in regards to any feature of energy absorption or safety features, such considerations cannot be considered by this Court. If plaintiff bases patentability of its patent on these features, the patent is invalid as failing to particularly point out and distinctly claim that which it alleges is the subject matter of its patent pursuant to Title 35 U.S.C. § 112.

INFRINGEMENT

[13] The Court next turns to the issue of infringement. It is the opinion of this Court that said issue is moot as the Court

has above found plaintiff's patent to be invalid. However, in the interest of judicial economy, the Court shall consider the evidence presented and make factual determinations on the issue of infringement.

[14, 15] The Court first notes that in responding to the charges of invalidity, plaintiff has asserted and attempted to adopt a very narrow construction of its claims of its patent, thereby attempting to distinguish relevant prior art from said claims. However, this Court notes that in urging infringement, plaintiff has adopted a pattern of attempting to read its claims more broadly to include the devices manufactured by defendant National. Plaintiff cannot urge a narrow construction concerning the validity and a broad interpretation in asserting infringement. Consistent readings of the patent in issue must be utilized by the Court in determining both validity and infringement. See *Dunlop Company, Ltd. v. Kelsey-Hayes Company*, 484 F.2d 407 (6th Cir. 1973).

Interpreting the claims of plaintiff's patent broadly, this Court comes to the conclusion noted above that the '226 Patent is invalid as it has been anticipated by prior art, as it is obvious or would have been obvious to those skilled in the art at the time the invention was made, and, if based in part or in whole upon the inherent safety factors, that it fails to state with particularity the invention claimed by the patentee.

Assuming *arguendo* that this Court were to construe the claims of the '226 Patent more narrowly, and assuming that such a reading would render said claim valid, such a reading would result in a finding of infringement by defendant National's 1059, 1060, and "Old 1070" seats.

In this regard, the Court first notes that all of National Seating's seats which have an aisle support or use the support pedestal in the aisle position do not infringe plaintiff's '226 Patent. Plaintiff's patent is addressed to a seat support at an intermediate or center position between the wall and the aisle side. Thus excluded from the claims of the patent are those seat supports which are placed at an aisle position. Plaintiff has attempted through various testimony and arguments to convince this Court that all of defendant's seats have their pedestals in an intermediate position. The Court finds plaintiff's arguments to be totally without merit.

Defendant argues that it does not infringe the '226 Patent, as said patent is addressed to transit chairs. Defendant asserts that recliner chairs do not fit into the description of transit chairs and that therefore one of the elements of the claims has not been infringed. However, this Court finds defendant's argument to be without merit.

[16, 17] The patent law provides that a patentee can be his own lexiocographer. See *Ellipse Corp. v. Ford Motor Co.*, 452 F.2d 163 (7th Cir. 1971). Thus, a patentee can utilize his own terms and define them for use in his patent as long as he remains consistent in his position. *Universal Oil Products Co. v. Globe Oil and Refining Co.*, 137 F.2d 3 (7th Cir. 1943), aff'd, 322 U.S. 471, 64 S.Ct. 1110, 88 L.Ed. 1399 (1944). Although it is unclear as to the exact definition of the term "transit" as used by plaintiff in its patent, this Court finds that the general and normal definition of said term would apply to both the inter-city and intra-city bus seating field and that therefore both stationary back and recliner back seats would be included in said term.

The Court notes that Plaintiff's Exhibit 132, which is a catalogue of American Seating's products, includes references to the following categories: driver seats, transit seats, school bus seats, non-recliner seats, and recliner seats. However, upon further review of this catalogue, it appears that American Seating uses the term transit seat in not only the transit category, but also in its non-recliner and recliner sections. Therefore, it appears to this Court that it is the consistent position of plaintiff American that the term transit seat includes both recliner and non-recliner seating arrangements.

Defendant also argues that its Old and New 1070 Models do not infringe plaintiff's

patent as the upright pedestals of said models are not connected to the frame that runs from the aisle to the wall transverse of the bus. Defendant asserts that in its seat the upright column is connected to two members of the frame which run longitudinally, not transversally, of the bus and that thereafter there are three beams that run transversally of the bus to support the seat.

It is the opinion of this Court that said argument is without merit as the actual support mechanism, whether it be attached directly to the beam or whether it be attached to two small metal pieces which are thereafter attached to a beam, is in essence the functional equivalents of one another and that therefore such a distinction is without merit.

Defendant further argues that its New Model 1070 does not infringe plaintiff's patent, asserting said seat pedestal has a different foot design than that disclosed in the '226 Patent. National's New Model 1070 foot design indicates a foot which is square cut on its ends and has an attachment flange welded thereto and extending outwardly from such square cut end. Such flanges are totally exposed from the tube and provide holes to receive the floor fasteners. Further, such exposed attachment flanges are each selectively covered by a four-wall closure cap. Defendant asserts that such a design permits better access to the fastening bolt and provides other advantages, to wit: a shorter overall foot, thereby improving ingress and egress, reduction in cost because of less material being utilized and easier installation of the pliable cap as well as the elimination of sharp corners.

Defendant asserts that the independent Claims 1 and 6 of plaintiff's patent include limitations describing the access apertures to the fastening bolts as being in or defined by the tube of the foot. Such limitations are not present in the New 1070 Model seat. Defendant further asserts that plaintiff, in its original application to the Patent Examiner, defined the foot as "being cut away at its upper end portions provide vertical access to said vehicle floor . . ." See Plaintiff's Exhibit 119. Said description was rejected by the Examiner who relied upon the combination of several patents including the Koch Patent 2,947,554 for its showing of a tube cut away at its end. The Patent Examiner held that it would have been obvious to make the ends of the pedestal feet as taught by Koch in his patent.

Plaintiff, upon submitting what was finally accepted to be the design for the foot in the '226 Patent, attempted to distinguish the Koch Patent on the basis that the fastener hole 29 and the attachment tab 27 of the Koch Patent were not within the tube as defined in the amended '226 claim, and that the ends of tube 23 in the Koch Patent did not define "an access aperture adjacent the associated bolt hole" as required by the Barecki claims.

The Court determines that plaintiff's arguments to the Patent Examiner in the prosecution of its patent foreclose the argument presently made to this Court urging infringement of defendant National's design. The Court determines that plaintiff is excluded by file wrapper estoppel from attempting to argue in the instant case that defendant's foot, almost identical to that described in the Koch Patent, infringes the '226 Patent. The Court therefore determines that National's "New Model 1070" seat does not infringe the claims of plaintiff's '226 Patent.

Further, upon review, it is the determination of this Court that all the elements of plaintiff's '226 Patent are included in the 1059, 1060 and the "Old 1070" seats manufactured by National.

[18] Thus, were plaintiff's '226 Patent valid, there would in fact be infringement by defendant National's seat Models 1059, 1060 and "Old 1070", but only for those seats of said models in which the pedestals were placed at a center or intermediate position. The Court specifically finds that those seats of Model 1059, 1060, and the "Old 1070", where the pedestals were placed in an aisle position, would not and do not infringe plaintiff's '226 Patent.

CONCLUSIONS

Therefore, this Court having found plaintiff's patent invalid under Title 35 U.S.C. § 102 as having been anticipated by the prior art; as being obvious to one skilled in the art at the time the invention was made under Title 35 U.S.C. § 103; and further having found that if plaintiff bases its contention of validity in part or in whole upon safety factors, the patent does not particularly point out and describe the invention claimed by the patentee as required by 35 U.S.C. § 112, this Court hereby finds for the defendant and against the plaintiff. This Court specifically finds United States Letters Patent No. 3,729,226 to be invalid and unenforceable.

Plaintiff to pay costs.

IT IS SO ORDERED.

Bernardino TORRES and Irma Torres, Plaintiffs,

v.

TOWMOTOR DIVISION OF CATERPILLAR, INC. and Foley Towlift Inc., Defendants.

No. 77 C 1810.

United States District Court, E. D. New York.

Nov. 18, 1977.

In product liability action, plaintiffs sought order of attachment of the defendant's insurance policy for the sole purpose of obtaining quasi in rem jurisdiction, relying on decision of the New York Court of Appeals, in *Seider v. Roth*. The District Court, Bramwell, J., held that: (1) in light of subsequent decision of the United States Supreme Court in *Shaffer v. Heitner*, in order for a state to presently assert quasi in rem jurisdiction, it must first be proved that the nonresident defendant has contacts, ties, or relations with the forum state so that the maintenance of the suit does not offend traditional notions of fair play and substantial justice; (2) the *Seider* decision cannot be regarded as creating direct action against the insurer, and (3) accordingly, where the only nexus the instant action had with New York was that nonresident defendant allegedly injured a person in New Jersey who happened to be a New York resident, but who was employed in New Jersey, quasi in rem jurisdiction could not be established by attachment of defendant's insurance policy solely on the basis that its insurer did business in New York.

Motion denied.

1. Courts ⇐96(3)
Federal Courts ⇐372

Where jurisdiction is based on diversity of citizenship, federal court will normally follow decisions of the highest court of the state in which it sits; however, where a state court decision on the issue of jurisdiction is challenged as constitutionally infirm, the federal court must be guided by the relevant decisions of the United States Supreme Court.

2. Courts ⇐12(2)

In order for a state to assert quasi in rem jurisdiction, it must first be proved that the nonresident defendant has contacts, ties, or relations with the forum state so that the maintenance of the suit does not offend "traditional notions of fair play and substantial justice." U.S.C.A.Const. Amend. 14.

3. Courts ⇐12(2)

Decision of the New York Court of Appeals in *Seider v. Roth* does not purport to create a direct assertion of jurisdiction over the insurer; rather, the "direct action" emanating from that decision is an effect of the decision only after quasi in rem jurisdiction has been validly acquired, and thus for a *Seider* attachment to continue to exist, it must do so as a species of quasi in rem

Cite as 586 F.2d 611 (1978)

AMERICAN SEATING COMPANY, Plaintiff-Appellant Cross-Appellee,

v.

NATIONAL SEATING COMPANY, Defendant-Appellee Cross-Appellant.

Nos. 76-2625, 76-2626.

United States Court of Appeals, Sixth Circuit.

Argued June 19, 1978.

Decided Sept. 15, 1978.

Suit was brought for infringement of patent No. 3,729,226, relating to a passenger bus seat that uses a tubular inverted "T" pedestal. The United States District Court for the Northern District of Ohio, Eastern Division, Leroy J. Contie, Jr., J., 457 F.Supp. 444, held that the patent was invalid. The court further held that if the patent were valid, it was infringed by some of defendant's seat models, and an appeal and cross appeal were taken. The Court of Appeals, Weick, Circuit Judge, held that: (1) presumption of the patent's validity was completely destroyed by reason of the fact that the concepts embodied in the uncited prior art possessed the most relevance in the determination of patentability, and (2) the patent was invalid because it was anticipated by the prior art, because it was obvious to one of ordinary skill in the art, and because it failed to describe particularly that which was claimed to be invented.

Affirmed.

1. Patents ⇐18, 37, 46

Patentability is dependent upon three essential elements, namely, novelty, utility, and nonobviousness. 35 U.S.C.A. §§ 101–103.

2. Patents ⇐18, 37, 46

Elements of novelty, utility, and nonobviousness constitute separate tests of patentability, each of which must be met in order for a patent to be valid. 35 U.S.C.A. §§ 101–103.

3. Patents ⇐112.1

Starting point in analyzing a challenge to a patent's validity is the statutory presumption that the patent is valid. 35 U.S.C.A. § 282.

4. Patents ⇐112.1

Presumption of patent validity is based upon the acknowledged experience and expertise of the patent office and upon the fact that the issuance of a patent constitutes a type of administrative determination supported by evidence. 35 U.S.C.A. § 282.

5. Patents ⇐112.1

In cases in which relevant prior art was not considered by the patent office, the presumption of patent validity is largely, if not wholly, vitiated. 35 U.S.C.A. § 282.

6. Patents ⇐112.1

Degree by which the presumption of patent validity is weakened in cases in which relevant prior art was not considered by the patent office depends upon a balancing of the pertinence of the newly cited prior art and the pertinence of the prior art actually considered by the patent examiner in the prosecution of the patent application. 35 U.S.C.A. § 282.

7. Patents ⇐112.1

Presumption of patent's validity was completely destroyed by reason of the fact that the concepts embodied in the uncited prior art possessed the most relevance in the determination of patentability. 35 U.S.C.A. § 282.

8. Patents ⇐37

Novelty does not exist if a patented device is anticipated by a substantially identical device whose elements perform substantially the same work in substantially the same manner. 35 U.S.C.A. §§ 102, 103.

9. Patents ⇐72(1)

A patent is anticipated if all the elements of the patented device, or their equivalents, are found in a single preexisting structure or description. 35 U.S.C.A. §§ 102, 103.

10. Patents ⇐324.55(4)

A finding of equivalence is a determination of fact which cannot be disturbed unless clearly erroneous. 35 U.S.C.A. §§ 102, 103.

11. Patents ⇐328(2)

Patent No. 3,729,226, relating to a passenger bus seat that uses a tubular inverted "T" pedestal, was invalid for anticipation, where the only significant difference between the seat disclosed by the patent and the prior art round base seats related to the shape of the pedestal feet, and where there was no difference in either the function performed by the tubular inverted "T" pedestal and the round-based pedestal, or in the manner in which the two types of pedestals perform their function. 35 U.S.C.A. §§ 102, 103.

12. Patents ⇐18

Patent relating to a passenger bus seat that uses a tubular inverted "T" pedestal was invalid for obviousness to one of ordinary skill in the art. 35 U.S.C.A. § 103.

13. Patents ⇐36(3)

Substantial evidence supported district court's finding that patent, relating to a passenger bus seat that uses a tubular inverted "T" pedestal, was a combination patent, but the combination of old elements failed to produce a synergistic effect or result, and the invention was thus unpatentable.

14. Patents ⇐26(1¼)

A combination of old elements, in order to be patentable, must produce a synergistic effect or result.

15. Patents ⇐26(1¼)

Combination of old elements in patent, relating to a passenger bus seat, to produce a seat which is superior to aisle leg seats because of its increased storage and leg room under the seat, its increased ease in maintenance and cleaning, its improved aesthetic qualities, and its increased ease in passenger egress and ingress could not properly be characterized as synergistic; nor was a synergistic effect provided by the alleged improved crashworthiness of the seat disclosed by the patent.

16. Patents ⇐36.1(1), 36.2(1)

Certain secondary considerations, such as commercial success, long-felt but unresolved needs, and the failure of others, may have some relevance in the determination of obviousness. 35 U.S.C.A. § 103.

17. Patents ⇐36.2(2)

Although in a close case secondary factors may tip the scales toward patent validity, they cannot save a patent from invalidity when there is a plain lack of invention, and obviousness is clear. 35 U.S.C.A. § 103.

Lloyd A. Heneveld, Price, Heneveld, Huizenga, Cooper, Daniel Van Dyke, Grand Rapids, Mich., for plaintiff-appellant cross-appellee.

Charles B. Lyon, Donnelly, Maky, Renner & Otto, Cleveland, Ohio, for defendant-appellee cross-appellant.

Before WEICK and MERRITT, Circuit Judges, and CECIL, Senior Circuit Judge.

WEICK, Circuit Judge.

This action was brought in the District Court by American Seating Company (American) against National Seating Company (National) for the infringement of its U.S. Letters Patent No. 3,729,226 ('226), entitled "Single Pedestal Transit Chair." National, in its answer, pleaded the invalidity of the patent and denied infringement, and counterclaimed for a declaratory judgment of invalidity and non-infringement.

In a well-written opinion District Judge Contie held that the patent was invalid under: (1) 35 U.S.C. § 102, because it was anticipated by the prior art; (2) 35 U.S.C. § 103, because it was obvious to those skilled in the art at the time of its invention; and (3) 35 U.S.C. § 112, because it failed to describe particularly that which was claimed to be invented. Furthermore the District Court found that the patent, if valid, was infringed by some of National's seat models, but was not infringed by other National seat models.

Both parties appealed. American has appealed from those portions of the District Court's judgment which held the patent invalid and which found that certain of National's seat models did not infringe upon the patent. National has cross-appealed from the District Court's findings of infringement.

We affirm, holding the patent invalid, and therefore it is not necessary that we reach the issues of infringement.

I

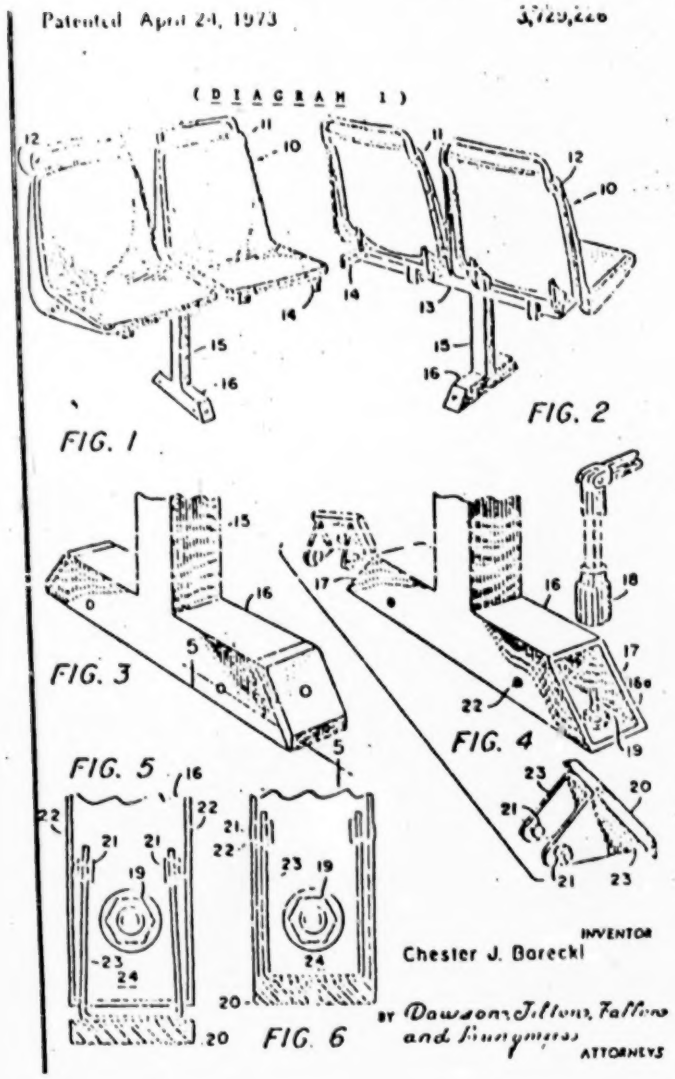
The '226 patent relates to a passenger bus seat. The device was invented around April, 1970, by Charles A. Barecki, an employee of American. The patent application (which application was assigned by Barecki to American) was filed in the U.S. Patent Office on June 4, 1971, and the patent was issued on April 24, 1973. American and National, at the time of suit, were the sole American manufacturers of intercity passenger bus seats.[1]

The '226 patent (see diagram 1) discloses a center pedestal seat. The patent claims[2] show two side-by-side seats (11 and 12) mounted on a beam (13). The beam is attached to the wall of a bus by an angle iron (14). The beam is supported approximately midway between the seats by a pedestal shaped in the form of an inverted "T". The pedestal is composed of a single upright column (15) and a tubular foot (16), which foot extends fore and aft of the bus. The ends (17) of the foot are cut away at a 45° angle to provide access openings to the fastening bolts (19) used to secure the foot to the floor. The access openings can be covered by end caps (20). The end caps are held in place by a U-shaped spring plate (23), which has two shoulder rivets or lugs (21) snapped into receiving holes (22).

[See following illustration.]

1. Apparently there are two markets for passenger bus seats, the inter-city market and the intra-city market. Inter-city passenger bus seats are recliner type seats, while intra-city passenger bus seats are for the most part non-recliner or fixed-back type seats. At the time of suit American was the dominant manufacturer of intra-city passenger bus seats. National, although previously having manufactured intra-city passenger bus seats, no longer did so at the time of trial.

2. The '226 patent contains six claims. Of the claims, claims one and six are independent. The other claims are dependent upon claim one.



Prior to the marketing of passenger bus seating with the tubular inverted "T" pedestal, the standard floor support used for passenger bus seats was aisle legs. American began to market passenger bus seats manufactured in conformity with the '226 patent in 1971. Since that time the tubular inverted "T" pedestal disclosed by the '226 patent has enjoyed considerable acceptance and commercial success as a mode of floor support for both inter-city and intra-city passenger bus seats. App. 1171–72.

In 1972 National first offered for sale a recliner passenger bus seat which used a tubular inverted "T" pedestal identical to the one disclosed by the '226 patent. Since its first use National has modified the pedestal's foot design so that the fastening bolts are located outside of the tube of the foot. At the time of trial all passenger bus seats manufactured by National used a tubular inverted "T" pedestal for the floor support.

The '226 patent sets forth the following advantages of its seat design, which advantages are alleged to be attributable to the tubular inverted "T" pedestal, over the traditional aisle leg passenger bus seat: (1) increased safety and ease in passenger ingress and egress; (2) increased leg room and storage space under the seat; (3) increased ease in maintenance and cleaning; and (4) improved appearance.

II

[1, 2] Patentability is dependent upon three essential elements, namely, novelty, utility, and nonobviousness, articulated and defined in 35 U.S.C. §§ 101-03. These elements constitute separate tests of patentability, each of which must be met in order for a patent to be valid. *United States v. Adams*, 383 U.S. 39, 48, 86 S.Ct. 708, 15 L.Ed.2d 572 (1966); *Reynolds Metals Co. v. Acorn Bldg. Components, Inc.*, 548 F.2d 155, 159 (6th Cir. 1977) and cases cited therein.

The District Court held that the '226 patent was invalid, *inter alia*, because it failed to meet two of the above tests, that is, the structure disclosed by the patent was anticipated, thereby negating novelty, *Allied Wheel Prods., Inc. v. Rude*, 206 F.2d 752, 760 (6th Cir. 1953), and the patent was obvious in light of the prior art.

[3–5] The starting point in analyzing a challenge to a patent's validity is the statutory presumption that the patent is valid under 35 U.S.C. § 282. The presumption of validity is based upon the acknowledged experience and expertise of the Patent Office and upon the fact that the issuance of a patent constitutes a type of administrative determination supported by evidence. *Parker v. Motorola, Inc.*, 524 F.2d 518, 521 (5th Cir. 1975), *cert. denied*, 425 U.S. 975, 96 S.Ct. 2175, 48 L.Ed.2d 799 (1976); *see Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 1234 (7th Cir. 1969), *cert. denied*, 397 U.S. 1037, 90 S.Ct. 1354, 25 L.Ed.2d 648 (1970); *Monroe Auto Equip. Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412-13 (6th Cir.), *cert. denied*, 379 U.S. 888, 85 S.Ct. 160, 13 L.Ed.2d 93 (1964). In cases in which relevant prior art was not considered by the Patent Office, the presumption is largely, if not wholly, vitiated. *Tee-Pak, Inc. v. St. Regis Paper Co.*, 491 F.2d 1193, 1196 (6th Cir. 1974); *Westwood Chem., Inc. v. Owens-Corning Fiberglas Corp.*, 445 F.2d 911, 916 (6th Cir. 1971), *cert. denied*, 405 U.S. 917, 92 S.Ct. 941, 30 L.Ed.2d 786 (1972).

[6] The degree by which the presumption is weakened in cases in which relevant prior art was not considered by the Patent Office, depends upon a balancing of the pertinence of the newly cited prior art and the pertinence of the prior art actually considered by the patent examiner in the prosecution of the patent application. *Tee-Pak, Inc. v. St. Regis Paper Co., supra*, 491 F.2d at 1193; *accord, Aluminum Co. of America v. Amerola Prods. Corp.*, 552 F.2d 1020, 1024-25 (3d Cir. 1977).

[7] In the instant case the District Court determined that the prior art con-

sidered by the Patent Office did not include "any showing of the overall combination claimed, a center pedestal for a two passenger transportation seats [sic] or concealed fasteners for such pedestals." App. 60. Because the concepts embodied in the uncited prior art possess the most relevance in the determination of patentability in this case, we agree with the District Court that the presumption of validity has been completely destroyed.[3]

III

[8] Novelty does not exist if a patented device is anticipated by a substantially identical device whose elements perform substantially the same work in substantially the same manner. *Dunlop Co. v. Kelsey-Hayes Co.*, 484 F.2d 407, 414 (6th Cir. 1973), *cert. denied*, 415 U.S. 917, 94 S.Ct. 1414, 39 L.Ed.2d 471 (1974); *Monroe Auto Equip. Co. v. Heckethorn Mfg. & Supply Co., supra*, 332 F.2d at 414.

The District Court found that two prior art seats anticipated the '226 patent. The first of these seats is the Greyhound Tour Coach Seat. (See diagram 2 below.) That seat, designed, manufactured, and sold by National to Greyhound in the 1950's, discloses:

> Said Tour Coach seat includes side-by-side recliner seats 11 and 12 supported on frame beam 13, having aisle side 13–A and wall side 13–B and mounting means 14 provided to secure the wall side of the frame to the vehicle wall. Frame 13 is also supported by a pedestal P, including a column 15 and a foot 16. Such foot 16 includes a circular bottom plate 16–A welded to the bottom of the upright column and four spaced gussets 16–B interconnecting the column 15 and the bottom plate 16–A. The bottom plate 16–A has four equally circumferentially spaced countersunk mounting holes 19–A therein to receive fasteners to secure the same to the vehicle floor. The foot 16 is selectively covered by a two-piece shroud 20, 20–A, joined by screws 21, such shroud acting to conceal the four spaced fasteners. The above described pedestal P can be positioned at the center of the seat frame for some seats or in an intermediate position between the center of the frame and the aisle side for other seats. [App. 47–49]

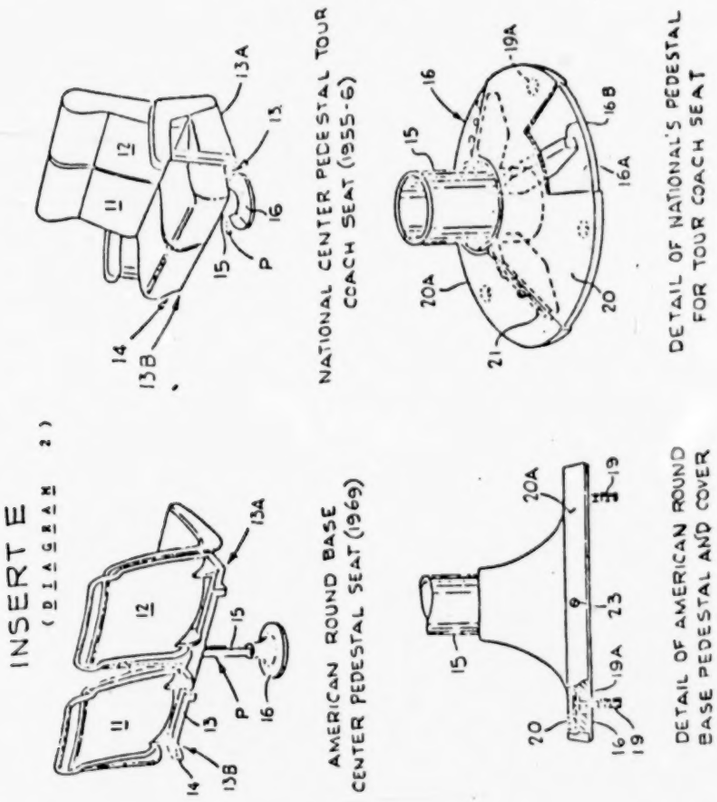
The second seat found by the District Court to anticipate the '226 patent, is the American round base center pedestal seat sold by American to General Motors Corporation in 1969.[4] (See diagram 2.) That seat discloses:

> Such seat includes two side-by-side transit [*i. e.*, fixed-back] seats 11 and 12 mounted on a tubular beam 13, having an aisle-side 13–A and a wall-side 13–B. Such wall-side of the frame is provided with a flange means 14 to secure the frame to the vehicle wall. The center pedestal P is provided to support frame 13 in conjunction with the wall mount, such pedestal including an upright cylindrical tubular column 15 and a cast foot 16 extending fore and aft of such column. Such foot 16 includes a plurality of counter-sunk holes 19–A adapted to receive floor fasteners 19 to secure the pedestal to the floor. The cast foot was selectively covered by a two-piece stainless steel shroud 20, 20–A interconnected by screws 23, such shroud acting to conceal the fasteners. [App. 51]

3. For example, neither of the prior art seats found by the District Court to anticipate patent '226 (one of which was developed by American) was considered by the Patent Office. In addition, the seat which possessed the pedestal most similar to the pedestal disclosed by the '226 patent, namely, the Heywood Wakefield Plane Mate Seat, was not cited by American to the patent examiner.

4. Hereinafter the Greyhound Tour Coach Seat and the American round base center pedestal seat will be referred to collectively as the "round base seats."

(DIAGRAM 2)


INSERT E
(DIAGRAM 2)
NATIONAL CENTER PEDESTAL TOUR COACH SEAT (1955-6)
AMERICAN ROUND BASE CENTER PEDESTAL SEAT (1969)
DETAIL OF NATIONAL'S PEDESTAL FOR TOUR COACH SEAT
DETAIL OF AMERICAN ROUND BASE PEDESTAL AND COVER

After setting forth what it believed to be the appropriate standard by which an anticipation is to be determined, namely, whether all the elements of a patented device *or their equivalents* are found in a single prior art device or description in which they perform substantially the same work in substantially the same way, the District Court found: (1) that there had been a public sale or use of the round base seats more than one year prior to the date of the patent application; (2) that the only significant distinction between the round base seats and the seat disclosed by the '226 patent related to the pedestals; (3) that the round base pedestals were the equivalents of the tubular inverted "T" pedestal; and (4) that, therefore, because all of the elements of

the '226 patent or their equivalents were found in single prior art references, the '226 patent was anticipated.

American contends that the District Court's finding of anticipation may not stand because it is premised upon a misunderstanding of the law of anticipation in that the Court impermissibly interjected into its determination the doctrine of equivalency. Although not clearly articulated, American appears to be arguing that patent law requires that the construction of the challenged device be identical to that of the prior art device or reference which is alleged to anticipate it, in order for there to be an anticipation. In this case, because even a perfunctory comparison of the round base pedestals and the tubular inverted "T" pedestal shows a substantial difference in their structures, American concludes that the '226 patent cannot possibly be anticipated by the round base seats.

[9] American's assertion, to put it simply, is not in accordance with patent law as it relates to anticipation. This Court has repeatedly defined the proper standard with respect to anticipation as requiring that all the elements of a patented device *or their equivalents* be found in a single pre-existing structure or description. *Tee-Pak, Inc. v. St. Regis Paper Co., supra*, 491 F.2d at 1198; *A. J. Indus., Inc. v. Dayton Steel Foundry Co.*, 394 F.2d 357, 359 (6th Cir. 1968), *Monroe Auto Equip. Co., v. Heckethorn Mfg. & Supply Co., supra*, 332 F.2d at 414; *Preformed Line Prods. Co. v. Fanner Mfg. Co.*, 328 F.2d 265, 271 (6th Cir.), *cert. denied*, 379 U.S. 846, 85 S.Ct. 56, 13 L.Ed.2d 51 (1964); *Firestone v. Aluminum Co. of America*, 285 F.2d 928, 930 (6th Cir. 1960); *Allied Wheel Prods., Inc. v. Rude, supra*, 206 F.2d at 760; *accord, Norton Co. v. Carborundum Co.*, 530 F.2d 435, 442 n. 18 (1st Cir. 1976); *Kahn v. Dynamics Corp. of America*, 508 F.2d 939, 943 (2d Cir.), *cert. denied*, 421 U.S. 930, 95 S.Ct. 1657, 44 L.Ed.2d 88 (1975); *Decca Ltd. v. United States*, 420 F.2d 1010, 1027 28, 190 Ct.Cl. 454, *cert. denied*, 400 U.S. 865, 91 S.Ct. 102, 27 L.Ed.2d 104 (1970); *Amphenol Corp. v. General Time Corp.*, 397 F.2d 431, 438 (7th Cir. 1968); *Greening Nursery Co. v. J & R Tool & Mfg. Co.*, 376 F.2d 738, 740 (8th Cir. 1967); *Inglett & Co. v. Everglades Fertilizer Co.*, 255 F.2d 342, 345 (5th Cir. 1958); Deller's Walker on Patents § 57 at 242, § 58 at 249, and § 77 at 374-76 (2d ed. 1964).

American next argues that even if the equivalency of the tubular inverted "T" pedestal and the round base pedestals is an appropriate consideration in determining the issue of anticipation, the District Court erred in finding the pedestals to be equivalents.

In *Olympic Fastening Systems, Inc. v. Textron, Inc.*, 504 F.2d 609, 619 (6th Cir. 1974), *cert. denied*, 420 U.S. 1004, 95 S.Ct. 1447, 43 L.Ed.2d 762 (1975), *quoting from Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608, 70 S.Ct. 854, 94 L.Ed. 1097 (1950), the Court said:

> Under the doctrine of equivalents "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, *even though they differ in name, form, or shape.*" (Emphasis added).

[10] A finding of equivalence is a determination of fact which cannot be disturbed unless clearly erroneous. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co., supra*, 339 U.S. at 609-10, 70 S.Ct. 854.

The essential purpose of the '226 patent was to provide a passenger bus seat which was superior to aisle leg seats aesthetically, in ease of cleaning and maintenance, in ease and safety of passenger egress and ingress, and in the amount of leg and storage room under the seat. These advantages stem from the use of a center pedestal floor support.

In our opinion it is patently obvious that the round base seats furnish, in the same manner, that is, by the use of a center pedestal floor support, the identical advantages over aisle leg seats.

[11] The only significant difference between the seat disclosed by the '226 patent and the round base seats, relates to the shape of the pedestal feet. There is no difference in either the function performed by the tubular inverted "T" pedestal and the round-based pedestal, or in the manner in which the two types of pedestals perform their function. Thus the District Court's finding that the pedestals are equivalents is not clearly erroneous.

In our opinion the District Court's determination that the '226 patent was invalid because it was anticipated, is correct.

IV

[12] Although our agreement with the District Court's finding of anticipation is sufficient to affirm that Court's holding of invalidity, we note further that even if the '226 patent were not anticipated by prior art, the patent has other fatal deficiencies, namely, its obviousness.

The resolution of the question of obviousness in deciding patent validity requires the determination of several basic factual inquiries set out by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 86 S.Ct. 684, 694, 15 L.Ed.2d 545 (1966), as follows:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.

When a District Court makes the inquiries required by *Graham v. John Deere Co., supra*, it makes findings of fact which are binding upon an appellate court, unless the findings are clearly erroneous. *Reynolds Metals Co. v. Acorn Bldg. Components, Inc., supra*, 548 F.2d at 161; *Kolene Corp. v. Motor City Metal Treating, Inc.*, 440 F.2d 77, 81 (6th Cir.), *cert. denied*, 404 U.S. 886, 92 S.Ct. 203, 30 L.Ed.2d 169 (1971).

Once the factual setting has been established, the ultimate determination of obviousness is "'a conclusion of law with which this Court may disagree on the established findings of fact.'" *Philips Indus., Inc. v. State Stove & Mfg. Co.*, 522 F.2d 1137, 1139 (6th Cir. 1975), *quoting from Kolene Corp. v. Motor City Metal Treating, Inc., supra*, 440 F.2d at 81; *accord, Reynolds Metals Co. v. Acorn Bldg. Components, Inc., supra*, 548 F.2d at 161.

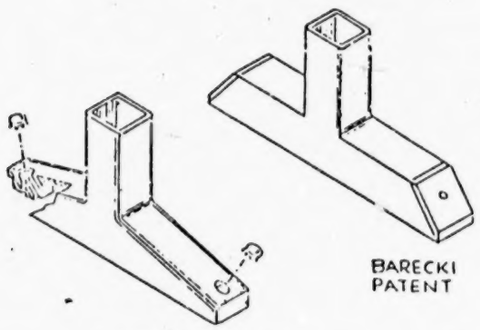
In holding the '226 patent invalid under § 103, the trial court found that none of the elements of the patent was new, and that they appeared in various prior art seats and patents. American contends that the District Court's finding that the '226 patent was a combination patent, is clearly erroneous because the patent contains one element not disclosed by the prior art, namely, the tubular inverted "T" pedestal.

We do not agree. The District Court made the following finding:

> Further, inverted T Pedestals were known in the seating art previous to the date of the invention. See the Blink Patent 198,218 and Howell sequence seating chairs. The Hozeski and Barecki Patent 3,567,281 disclosed an inverted T-type pedestal which illustrates advantages concerning maintenance reduction and concealed fasteners to avoid dirt collection. The Greyhound Tour Coach seat, the BART seats, National's 1040 leg, the plugs used in the Heywood Wakefield Plane Mate seat, and the stainless steel cover used by American on its round base center pedestal seat all illustrate the use of selectively covered floor fasteners. [App. 54]

The District Court further found the following:

> [T]he design of plaintiff's column and foot on the '226 Patent is obvious in light of the Heywood Wakefield inverted T Plane Mate pedestal (see diagram below). The Wakefield pedestal includes a tubular type upright to support chairs or seats and a channel shaped foot extending fore and aft therefrom. Such foot is provided with base plates at each end thereof, such base plates being provided with holes to receive floor fasteners.
>
> [See following illustration.]



[App. 55]

The District Court found, further, as follows:

> Even a cursory glance at the Heywood Wakefield inverted T Plane Mate Pedestal, used in 1969, indicates an almost identical structure as that claimed by plaintiff in its patent. Plaintiff asserts that the Heywood Wakefield inverted pedestal provides for a channel at the bottom of the foot as opposed to a hollow tubular foot. The Court finds this distinction to be without merit as the same function and use results from the Heywood Wakefield inverted T Plane Mate Pedestal as does that in the plaintiff's invention in the '226 Patent.
>
> Plaintiff contends that the pedestal of the patent in suit is distinguishable from the round base pedestal of the Tour Coach seat, as well as all other round base pedestals, and is unique in its function and advantages from round base pedestals. The Court cannot agree with this conclusion. This Court finds that the round based foot and the foot of the '226 Patent in suit are the functional equivalents of one another, and that the '226 foot does not function in any new or different mode, nor does it provide any new or different result. [App. 57-58]

[13] Our independent examination of the evidence relied upon by the District Court persuades us that its finding that the '226 patent is a combination patent is not clearly erroneous, but to the contrary, is supported by substantial evidence.

[14] As recognized by the District Court, because the '226 patent is composed of a combination of old elements, the combination, in order to be patentable, must produce a synergistic effect or result. *See Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 96 S.Ct. 1532, 47 L.Ed.2d 784 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61, 90 S.Ct. 305, 24 L.Ed.2d 258 (1969); *Kearney & Trecker Corp. v. Cincinnati Milacron Inc.*, 562 F.2d 365, 370 (6th Cir. 1977); *Reynolds Metals Co. v. Acorn Bldg. Components, Inc.*, *supra*, 548 F.2d at 161; *Philips Indus., Inc. v. State Stove & Mfg. Co.*, *supra*, 522 F.2d at 1141; *Dickstein v. Seventy Corp.*, 522 F.2d 1294, 1298-99 (6th Cir. 1975), *cert. denied*, 423 U.S. 1055, 96 S.Ct. 787, 46 L.Ed.2d 644 (1976).

In *Kearney & Trecker Corp. v. Cincinnati Milacron Inc.*, *supra*, 562 F.2d at 370, this Court, speaking through Circuit Judge Lively, recently defined synergism as follows:

> The synergistic test is met when a combination of elements produces an effect which is "greater than the sum of the several effects taken separately." *Anderson's-Black Rock*, *supra*, 396 U.S. at 61, 90 S.Ct. at 308. There must be an "impalpable something" in the combination itself which consists of previously known elements to pass the requirement of nonobviousness. *Philips Industries*, *supra*, 522 F.2d at 1141. Stated another way, there must be some "unusual or surprising result" from a combination of old elements. *Dickstein*, *supra*, 522 F.2d at 1299.

[15] We cannot agree with American's assertion that the combination of the old elements in the '226 patent to produce a passenger bus seat which is superior to aisle leg seats because of its increased storage and leg room under the seat, its increased ease in maintenance and cleaning, its improved aesthetic qualities, and its increas.d ease in passenger egress and ingress, can be characterized properly as synergistic. The District Court found that several prior art seats, namely, the Plane Mate Seat and the round base seats, furnished the identical advantages over aisle leg seats. This finding of fact is supported by substantial evidence and is not clearly erroneous.

Further, we cannot accept American's argument that a synergistic effect is provided by the alleged improved crashworthiness of the seat disclosed by the '226 patent, which improved crashworthiness is the result of an alleged increase in the energy absorption characteristics of the tubular inverted "T" pedestal. This function is completely omitted in the patent's specifications. No argument as to improved crashworthiness was raised before the Patent Office. As stated by the Court in *Graham v. John Deere Co.*, *supra*, 383 U.S. at 25, 86 S.Ct. at 697, *quoting from Lincoln Eng'r Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 550, 58 S.Ct. 662, 82 L.Ed. 1008 (1938):

> If this were so vital an element in the functioning of the apparatus, it is strange that all mention of it was omitted.

Moreover, American's evidence of improved crashworthiness of the '226 patent consists only of a comparison of the energy absorption characteristics of the tubular inverted "T" pedestal and aisle legs. American introduced no evidence that the tubular inverted "T" pedestal is more crashworthy than other types of prior art pedestals such as the pedestals of the round base seats. Without such evidence we fail to see how we, or the District Court, could conclude that the combination of the components of the '226 patent produces a new or different function which is absent in the prior art.

In our opinion, American's suggestion that a synergistic result is evidenced by the alleged improvement in crashworthiness is nothing more than an afterthought of an astute patent trial attorney. *Graham v. John Deere Co.*, *supra*, 383 U.S. at 25, 86 S.Ct. 684; *Lincoln Eng'r Co. v. Stewart-Warner Corp.*, *supra*, 303 U.S. at 550, 58 S.Ct. 662.[5]

We agree with the District Court's conclusion that the '226 patent fails to provide the requisite synergistic effect needed by combination patents, for validity. As stated by the Supreme Court in *Sakraida v. AG Pro, Inc.*, *supra*, 425 U.S. at 282, 96 S.Ct. at 1537:

> [T]his patent simply arranges old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations. Such combinations are not patentable under standards appropriate for a combination patent. *Great A. & P. Tea Co. v. Supermarket Corp.*, *supra* [340 U.S. 147,

5. The District Court also found that the alleged safety feature of the '226 patent "would necessarily relate to the tensile strength, gauge, size, shape, and type of material used in said upright column and foot. The patent in issue is silent as to any such references." [App. 60-61.] Based on this finding, the Court held the patent invalid for failing to point out particularly, and to claim distinctly the subject matter of the invention.

71 S.Ct. 127, 95 L.Ed. 162 (1950)][6]; *Anderson's-Black Rock v. Pavement Co., supra.* Under those authorities this assembly of old elements . . . falls under the head of "the work of the skilful mechanic, not that of the inventor." *Hotchkiss v. Greenwood,* [52 U.S. (11 How.) 248, 267, 13 L.Ed. 683 (1850)].

[16] We recognize that certain secondary considerations, such as commercial success, long felt but unresolved needs, and the failure of others, may have some relevance in the determination of obviousness. *Graham v. John Deere Co., supra,* 383 U.S. at 17–18, 86 S.Ct. 684; *Reynolds Metals Co. v. Acorn Bldg. Components, Inc., supra,* 548 F.2d at 161–62. The District Court, in resolving the obviousness issue, did not consider and make findings with respect to American's contentions relating to (1) the long felt need for and commercial success of the '226 patent, (2) the failure of National to develop a viable center pedestal passenger bus seat, and (3) National's copying of the tubular inverted "T" pedestal disclosed by the '226 patent, within a short period after American placed it on the market. We find no reversible error in the District Court's failure to take into account these secondary factors in reaching its decision on the question of obviousness in this case.

[17] Although in a close case secondary factors may tip the scales toward patent validity, they cannot save a patent from invalidity when, as in the case here, there is such a plain lack of invention, and obviousness is clear. *Graham v. John Deere Co., supra,* 383 U.S. at 35–36, 86 S.Ct. 684; *Kamei-Autokomfort v. Eurasian Automotive Prods.,* 553 F.2d 603, 606 (9th Cir.), *cert. denied,* 434 U.S. 860, 98 S.Ct. 186, 54 L.Ed.2d 133 (1977); *T. P. Labs., Inc. v. Huge,* 371 F.2d 231, 236 (7th Cir. 1966).

The '226 patent is invalid because it was anticipated by the prior art under the provisions of 35 U.S.C. § 102, because it was obvious to one of ordinary skill in the art under the provisions of 35 U.S.C. § 103, and because it failed to describe particularly that which was claimed to be invented under 35 U.S.C. § 112. Because the patent is invalid, it is unnecessary to reach the other issues raised by this appeal, including the issues of infringement.

Costs are to be assessed against American.

Affirmed.

John E. JONES, Plaintiff-Appellee,

v.

CITY OF MEMPHIS, TENNESSEE et al., Defendants-Appellants.

No. 77-1704.

United States Court of Appeals, Sixth Circuit.

Argued June 20, 1978.

Decided Sept. 19, 1978.

Suit was brought against city and certain John Doe police officers who, in the course of their employment, allegedly deprived plaintiff of his constitutional rights by illegally arresting and beating him. The United Stated District Court for the Western District of Tennessee, Bailey Brown, Chief Judge, 444 F.Supp. 27, concluded that the city could be held liable under the doctrine of respondeat superior and denied the city's motion to dismiss. Leave to appeal was granted, and the Court of Appeals, Harry Phillips, Chief Judge, held that the doctrine of respondeat superior was not applicable to actions brought against a municipal corporation directly under the Fourteenth Amendment and the general federal question statute.

Reversed and remanded with directions.

6. The patent in suit is just "as flimsy and as spurious" as that involved in *Great A. & P. Tea Co., supra. Cf., id.* at 158, 71 S.Ct. 127 (Douglas, J., concurring).

United States Patent [19] [11] **3,729,226**

Barecki [45] **Apr. 24, 1973**

[54] **SINGLE PEDESTAL TRANSIT CHAIR**

[75] Inventor: **Chester J. Barecki, Grand Rapids, Mich**

[73] Assignee: **American Seating Company, Grand Rapids, Mich**

[22] Filed: **June 4, 1971**

[21] Appl. No. **149,947**

[52] U.S. Cl. **297/232, 297/445, 248/188.8**

[51] Int. Cl. **A47c 3/00**

[58] Field of Search **297/248, 232, 445, 248/188.1, 188.8, 361, 188.7, 188.9, 188, 108/150, 211/182, 287/189.36 E, 56, 52/127**

[56] **References Cited**

UNITED STATES PATENTS

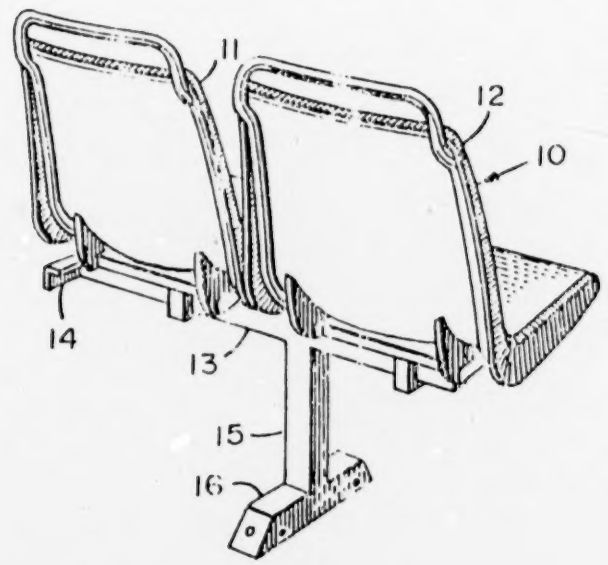
3,491,158	3/1951	Davis	297/445 X
2,006,502	7/1935	Halbowell	248/188.8 X
2,927,551	8/1960	Koch	211/182 X
2,991,838	7/1961	Shreck	211/182 X
3,194,362	7/1965	Wargo	52/127 X
3,586,369	1/1971	Brohn	287/56 X
3,337,199	10/1967	Holz	248/188.7
3,567,278	3/1971	Barecki	297/457 X
2,992,803	7/1961	Gossl	248/188.7
3,236,484	2/1966	Hozeski	248/188

Primary Examiner Francis K. Zugel
Attorney Dawson, Tilton, Fallon & Lungmus

[57] **ABSTRACT**

A transit chair has a beam supporting two seats and has a side rail for attachment to the side of a vehicle, the beam being supported about midway by a single pedestal which is carried on a hollow foot extending longitudinally of the vehicle floor, the foot being provided at its ends with bolt openings for receiving bolts anchoring the foot to the floor and the foot being cut away along an angle above the openings to provide vertical access for a socket wrench, the ends of the foot being releasably closed by a closure cap having releasable wing lugs interlocked with side openings in the foot.

6 Claims, 6 Drawing Figures



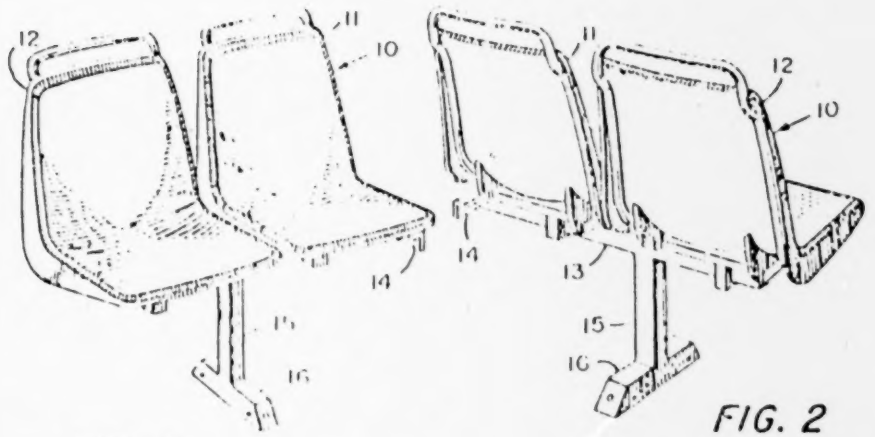


FIG. 1

FIG. 2

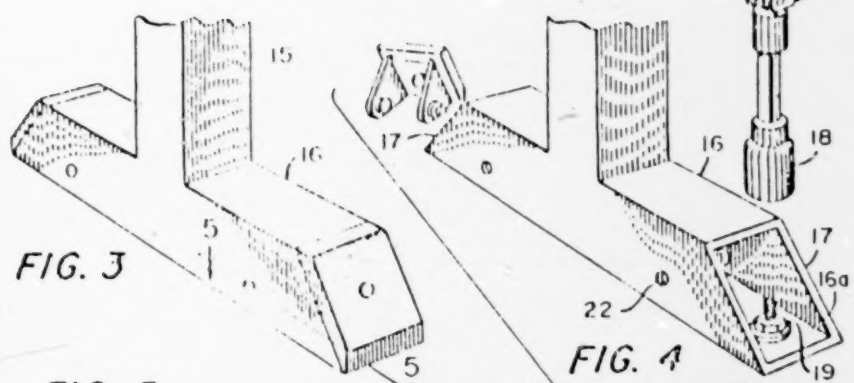


FIG. 3

FIG. 4

F'G. 5

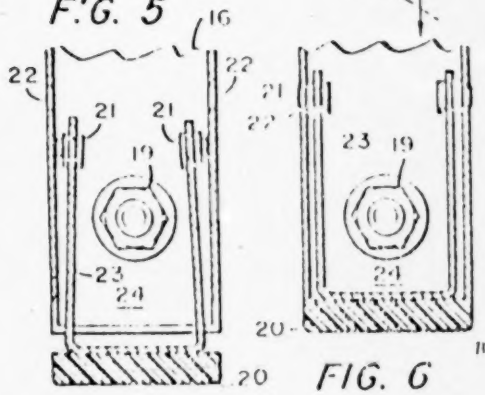


FIG. 6

INVENTOR
Chester J. Barecki

BY Dawson, Sutton, Fallon and Youngman
ATTORNEYS

1

SINGLE PEDESTAL TRANSIT CHAIR

BACKGROUND AND SUMMARY

In buses, planes, and other vehicles there is a need for sturdy support means for chairs, while at the same time providing maximum clearance between the chairs and the vehicle floor which permits quick and easy floor cleaning, leg room, and storage space. I have discovered that the above can be accomplished by supporting a pair of seats upon a cross beam which can be secured on one side to a side wall of the vehicle and supporting the beam about midway with a single pedestal having an elongated hollow foot extending in a direction longitudinally of the vehicle floor, while also providing a foot structure which can be firmly locked to the floor through exposed ends of the hollow foot while providing closures which can be removed from time to time when the fastening means must be retightened. An elongated hollow foot has its bottom ends provided with openings for receiving bolts, the ends of the foot being cut away at an angle to provide vertical access for a socket wrench, releasable closure caps being provided for the ends of the foot.

DRAWING

In the accompanying drawing,

FIG. 1 is a perspective view of the front side of a transit chair providing two passenger seats,

FIG. 2, a rear perspective view of the chair shown in FIG. 1,

FIG. 3, a broken perspective view on an enlarged scale of the foot of the pedestal,

FIG. 4, an exploded perspective view of the foot structure shown in FIG. 3 but with the end caps removed to expose the attachment means and to provide vertical clearance for a socket wrench,

FIG. 5, a broken sectional view, the section being taken as indicated at line 5—5 of FIG. 3, the end cap being partially pressed into the hollow foot, and

FIG. 6, a view similar to FIG. 5 but showing the end closure cap locked in place.

DETAILED DESCRIPTION

In general, I have provided a two seat chair structure carried by a beam, the beam being supported about midway by a single pedestal having at its bottom an elongated hollow foot, the foot extending longitudinally or lengthwise of the vehicle so as to prevent any swaying of the chair during the starting and stopping of the coach. The elongated foot has its end portions cut away to provide vertical access to bolts passing through the bottom ends so that the foot can be firmly anchored to the vehicle floor and later retightened should the bolts work loose. Closure cap means are provided for closing the end openings with wing lugs which snap into holes in the sides of the foot so that the caps can be removed for such tightening operations at later times.

Referring to the drawing, the transit chair 10 comprises two separate seat structures 11 and 12 mounted on a beam 13. The beam may be attached to the wall of the coach or vehicle by use of a short length of angle iron 14. The beam is supported by a single column pedestal 15 located about midway between the seats to afford maximum leg room without depriving the chair of the needed support.

2

The pedestal 15 is attached to the floor by the use of the elongated tube or foot 16 which extends in a direction longitudinally of the coach floor and includes a flat bottom plate 16a resting on the vehicle floor and secured to it. In the illustration given, the foot is substantially square in cross section and has its ends 17 cut away at an angle preferably about 45° to permit the use of a socket wrench 18 to tighten the attachment nuts or bolts 19 which are received in bolt holes at each end of the bottom plate 16a. Hence, the fastening bolts are located in fore and aft positions relative to the single vertical column 15, and they extend at least partially within the hollow foot member 16.

End caps 20 are locked in place automatically by having two shoulder rivets or lugs 21 snap into receiving holes 22 as the two spring fingers or wings 23 of the end cap are pressed inside the foot tube and along its bottom edge 24. When locked in place, the shoulder rivets or lugs hold the end cap 20 firmly against the opening 17 at each end of the foot 16. To remove the cap, the rivet lugs 21 should be pressed inwardly to clear the openings 22 and the closure then withdrawn. This structure prevents unauthorized removal. If desired, a special tool may be employed for simultaneously pushing the shoulder rivets inwardly on each side of the holes and thus facilitating the removal of the caps.

While in the foregoing specification I have shown structure in considerable detail for the purpose of illustrating phases of the invention, it will be understood that such details may be varied widely by those skilled in the art without departing from the spirit of my invention.

I claim

1. A multiple-passenger transit vehicle chair comprising a chair frame with an aisle side and a wall side, said frame supporting a plurality of passenger chairs side-by-side, mounting means on said wall side of said frame for securing said frame to a vehicle wall, a single pedestal cooperating with said wall to support said frame, said pedestal being spaced at an intermediate location between said wall side and said aisle side of said frame and including an upright column rigidly connected at its top to said frame, a hollow tubular foot member integral with the bottom of said column and extending forwardly and rearwardly therefrom, said foot having a generally flat bottom plate resting on the floor of said vehicle and provided with a bolt hole adjacent each end thereof to receive floor fastening bolts securing said foot to the vehicle floor at forward and rearward positions relative to said column, said tubular foot member further defining forward and rear access apertures adjacent their associated bolt holes to permit access to said fastening bolts when they are received in said bolt holes, said first and second closure means removably attached to said foot to cover said access apertures of said foot member respectively and cooperating with said hollow foot member to enclose said fastening bolts when said closures are assembled to said foot while permitting unrestricted tool access to said fastening bolts when said closures are removed.

2. The structure of claim 1 wherein said column of said pedestal is located at the approximate longitudinal and transverse center of the seat portion of said frame and wherein said mounting means comprises flange

means attached to said frame for securing the same to the vehicle wall.

3. The structure of claim 1 wherein said tubular foot member has a rectilinear cross section with open forward and rear ends providing said access apertures, said access apertures extending at an inclination relative to the horizontal from the bottom plate of said foot member upwardly and toward said column member, thereby permitting vertical as well as side tool access.

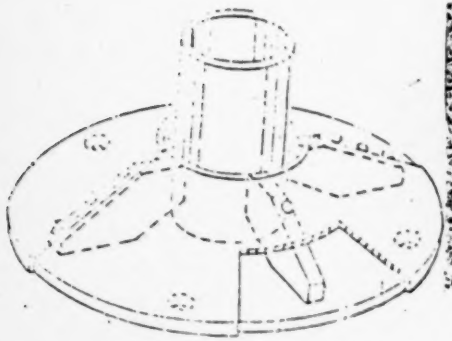
4. The structure of claim 1 wherein said frame comprises a cross beam extending longitudinally of said chair, and wherein said mounting means comprises a rail carried by said cross beam, said structure further comprising a pair of seats mounted upon said cross beam in side by side relation.

5. The structure of claim 3 wherein said closure means comprise first and second end plates covering respectively said front and rear inclined access apertures of said hollow rectilinear foot member.

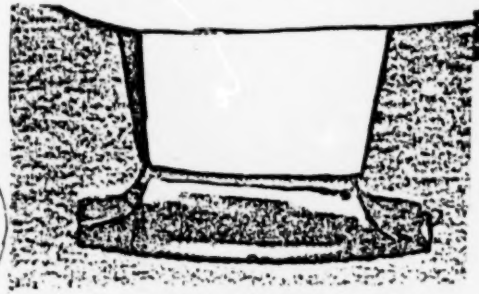
6. A two-passenger transit vehicle chair comprising a chair frame with an aisle side and a wall side, first and second chairs carried by said frame in side by side relation, mounting means securing the wall side of said frame to an upright vehicle wall, a single pedestal supporting said frame and including an upright column member connected to said frame at its approximate longitudinal midpoint and an integral hollow tubular foot member extending fore and aft of said chair from the bottom of said column member, said wall mounting means and said pedestal being the only support for said frame and said chair, said foot having a generally rectilinear cross section and having forward and rear open ends defining forward and rear access apertures, each of said open ends being inclined from the bottom of said foot upwardly and toward said column, first and second fastening bolts attaching said foot member to said floor of said vehicle at locations adjacent respectively said forward and rear access apertures, said bolts extending at least partially within said hollow foot member, and first and second cover members releasably attached to said hollow foot member to cover respectively said forward and rear access apertures, said access apertures extending from the side of an associated fastening bolt over and above the same to permit unrestricted tool access to a fastening bolt when the associated cover is removed.

* * * * *

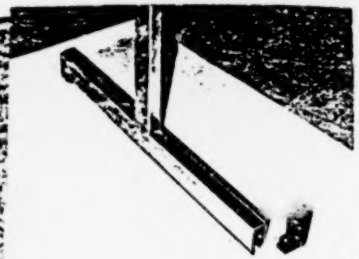
STRUCTURE RELIED UPON BY COURT AND OF WHICH EDWARDS HAD KNOWLEDGE DURING HIS EXTENSIVE ATTEMPT TO DEVELOP A CENTER PEDESTAL SEAT FROM 1970-1972



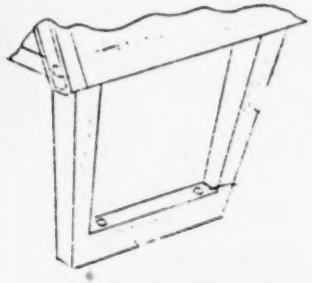
National's Pedestal
For Tour Coach Seat 1965



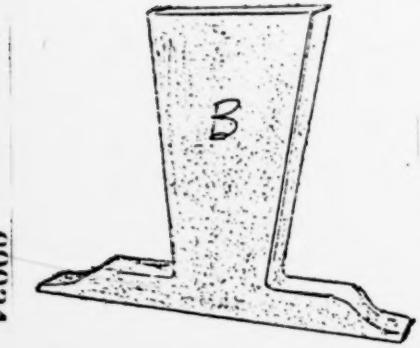
BART Seat
Pedestal 1965



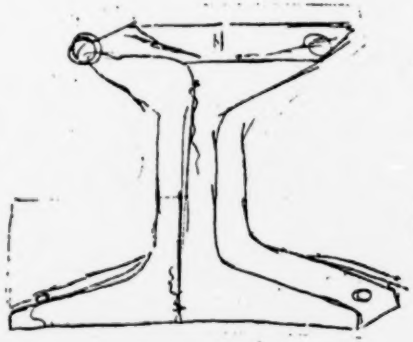
Mitchell Table
Pedestal - Known By
Edwards 1967-1975



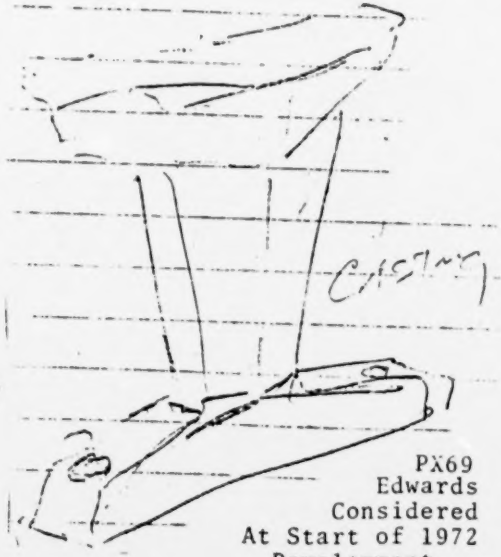
DX-VQ - Proposed
Tubular Foot For
National's 1010 Seat
(1958 - 1959)



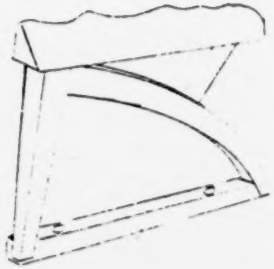
PX65 - Designed For
National 1958 and Considered
By Edwards 1970-1972



PX66AA Inverted T
Pedestal Considered
By Edwards 1970

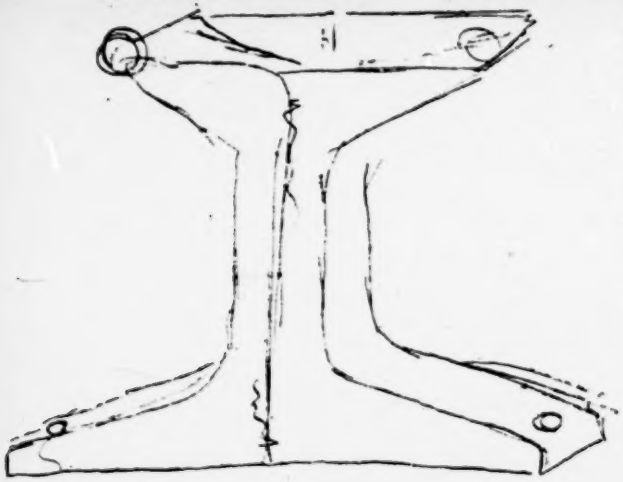


PX69
Edwards
Considered
At Start of 1972
Development

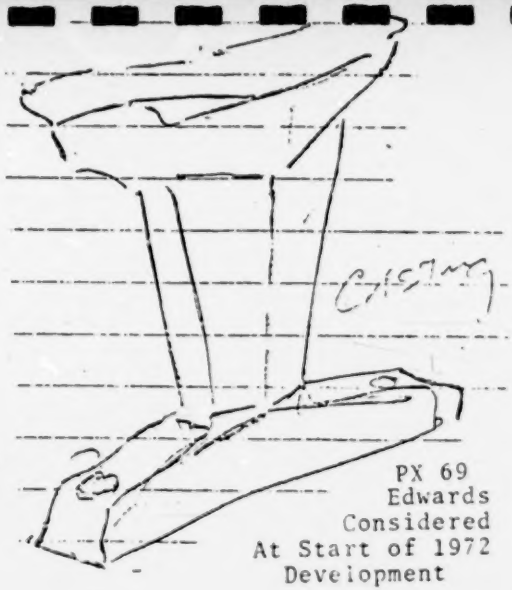


DX-FJ - Proposed
Tubular Foot On
National's 1025-
1031 Seat (1963)

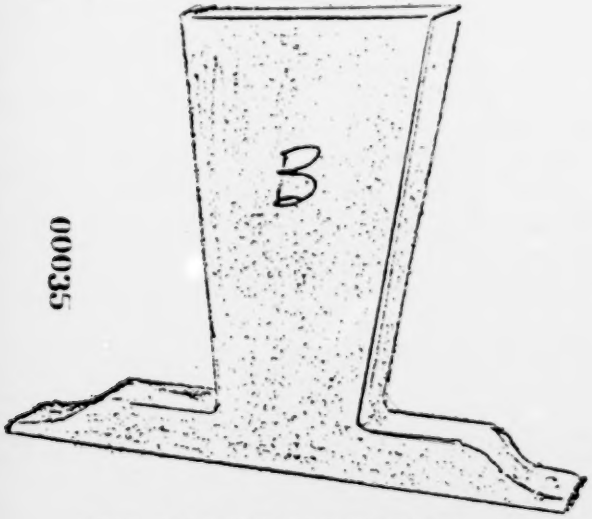
00034



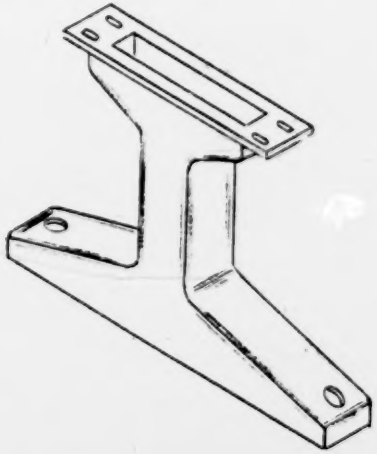
PX66 AA INVERTED T PEDESTAL
CONSIDERED BY EDWARDS 1970



PX 69
Edwards
Considered
At Start of 1972
Development



PX65 DESIGNED FOR NATIONAL 1958
AND CONSIDERED BY EDWARDS 1970-1972



HEYWOOD WAKEFIELD IN-
VERTED T PLANE MATE PEDESTAL (1969)

00035

A Right.

Q And that is what you were doing during 1970 to 1972; is that correct?

A Off and on, yes.

Q And finally you found one, didn't you?

A Oh, we finally settled on one, yes.

Q What was that?

A That was the tubular columns copied from the Mitchell table.

Q Like that shown in this courtroom which has been identified as Defendant's Exhibit SY?

A That was the final version of it, yes.

Q What are the dates of CF-1 to -25?

A They run from June, 1970, and I am not quite sure when the other ones are. They all run approximately within a month of one another.

Q And you say that you completed your present design sometime in September, 1972?

A Right.

Q And that is two years ago and three months; isn't it?

A I suppose so.

Q All this time you have been looking for a design that you can make at a price that you can sell?

A No. This project was brought up and started by

nylon with the tubular "T" pedestal. This was run in passenger transport on March 12, April 23, June 11, August 6 of 1971.

The next ad is "American Seating Presents: 'Two for the Road,* " as a deluxe single back and seat, two passenger bus seats, again showing the tubular "T" pedestal. This was run in passenger transport October 1 and October 29 of 1971.

The next one is an ad, "When it comes to design innovation, we'll try anything once." It shows the 6463 and a picture of Chet Barecki. This was run in passenger transport June 16 and October 6, 1972. This unit has a pedestal which was specially designed and made for CKA.

Q Do you recall to whom the first tubular "T" pedestals were sold?

A Yes, Peoria, Illinois.

Q Would you refer to Plaintiff's Exhibit 161 and determine if this refreshes your memory as to the dates that was sold?

A The order was entered on February 11, 1971, and this is a copy of the billing, including all the other sheets that go along with the billing.

Q What date did you say?

A February 11, 1971 is the date the order was entered. It was for 33 seats of 6455.

Q This is the first date that you sold a city service seat, is that correct, with the tubular "T" pedestal?

A Yes, the "T" pedestal, correct. The second sheet spells

Court Reporters, Inc.
Stenotype Reporters
Akron - Canton, Ohio

New National 1070...the spacemaker

greater comfort for passengers more profit for operators

In bus seating, just a little more space per passenger can make the difference between riding cramped or riding comfortable.

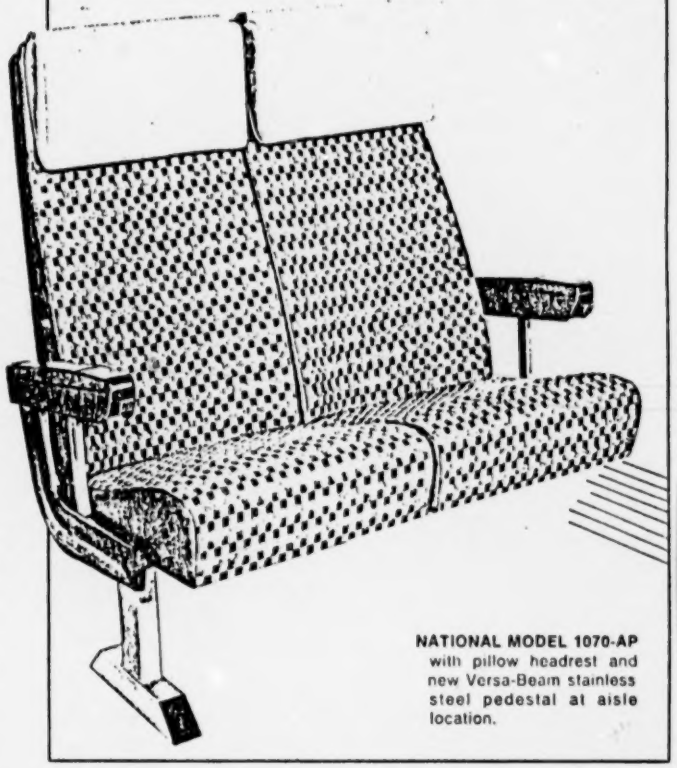
No one knows this more than bus operators. Yet space is always at a premium and must be used for maximum passenger capacity. That's why, when we designed the new National 1070, we carefully engineered in all the passenger space we could create. And we succeeded . . . with extra leg room, extra hip room and extra shoulder room. Here's the rundown on the new space-making features:

More shoulder room – full width seat backs. Now larger passengers sit more relaxed with extra shoulder support backed by the cushioned comfort of Pirelli webbing and resilient urethane foam. A slightly raised headrest also better accommodates your taller passengers.

More hip room – A narrower, slightly bowed arm rest support on the aisle side makes the difference – adds extra space where it is often most needed.

More knee, leg and foot room were created by designing in a wide recess in the seat back, raising the seat back a trifle, repositioning the optional footrest so it is completely out of the way in its retracted position. Equally important, National's new **Versa Beam**™ seat support doesn't interfere with free foot movement and allows passengers to get in and out without having to avoid conventional style seat legs.

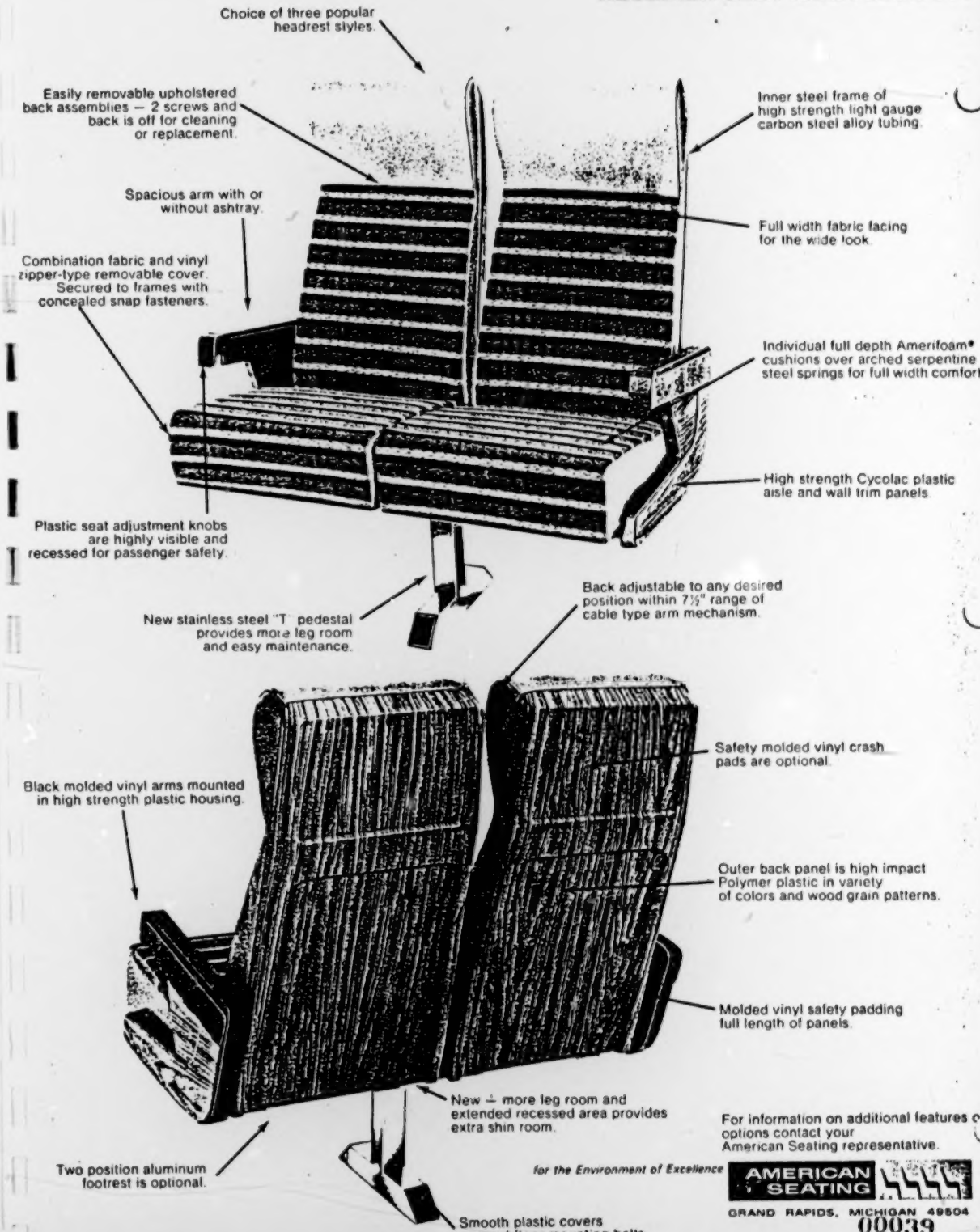
And, National's new 1070 series seats are **on the beam** in many other ways, too . . . with benefits most important to your operation – structural strength, quality construction, durability of materials, minimum maintenance and easy housekeeping . . . plus options to give you exactly what you want for your type of service.



NATIONAL MODEL 1070-AP with pillow headrest and new Versa-Beam stainless steel pedestal at aisle location.

NATIONAL MODEL 1070-CP with pillow headrest and new Versa-Beam stainless steel pedestal in center position. 00038

RECLINER SEAT Model 6630/31T


Choice of three popular headrest styles.
Easily removable upholstered back assemblies — 2 screws and back is off for cleaning or replacement.
Inner steel frame of high strength light gauge carbon steel alloy tubing.
Spacious arm with or without ashtray.
Full width fabric facing for the wide look.
Combination fabric and vinyl zipper-type removable cover. Secured to frames with concealed snap fasteners.
Individual full depth Amerifoam® cushions over arched serpentine steel springs for full width comfort.
High strength Cycolac plastic aisle and wall trim panels.
Plastic seat adjustment knobs are highly visible and recessed for passenger safety.
New stainless steel "T" pedestal provides more leg room and easy maintenance.
Back adjustable to any desired position within 7½" range of cable type arm mechanism.
Safety molded vinyl crash pads are optional.
Black molded vinyl arms mounted in high strength plastic housing.
Outer back panel is high impact Polymer plastic in variety of colors and wood grain patterns.
Molded vinyl safety padding full length of panels.
New – more leg room and extended recessed area provides extra shin room.
Two position aluminum footrest is optional.
Smooth plastic covers conceal floor mounting bolts for easy cleaning.

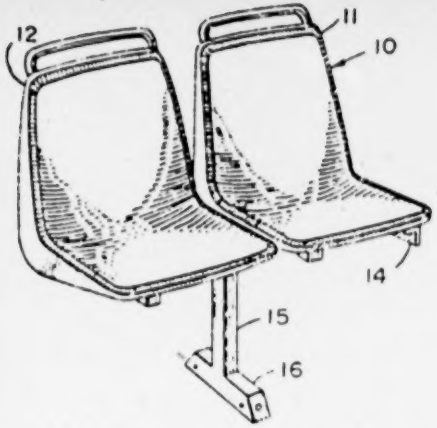
For information on additional features or options contact your American Seating representative.

for the Environment of Excellence

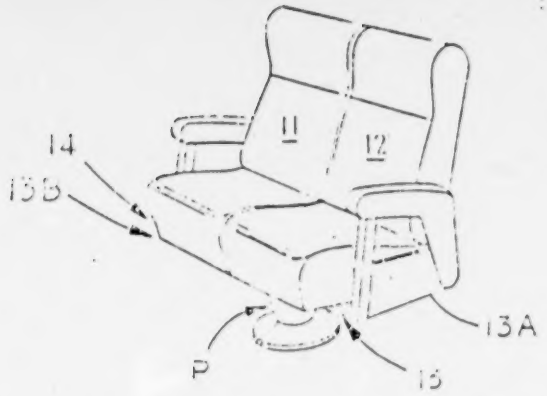
AMERICAN SEATING

GRAND RAPIDS, MICHIGAN 49504

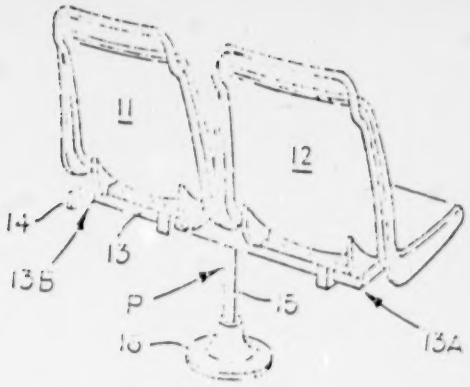
00039



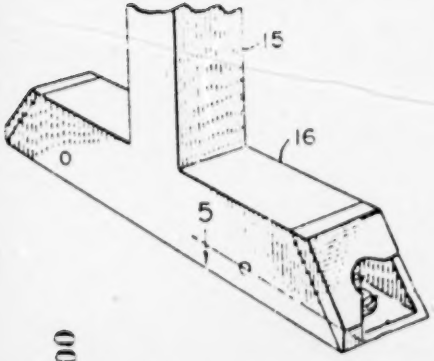
PATENTED SEAT



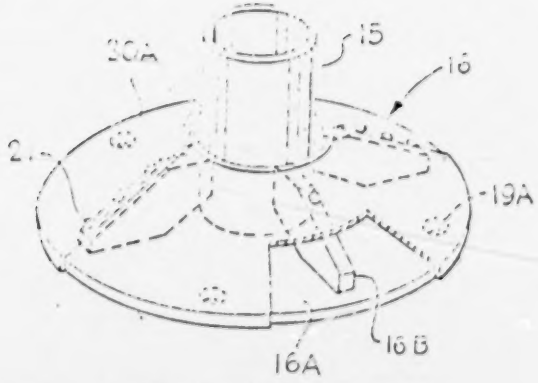
NATIONAL CENTER PEDESTAL TOUR COACH SEAT (1955-6)



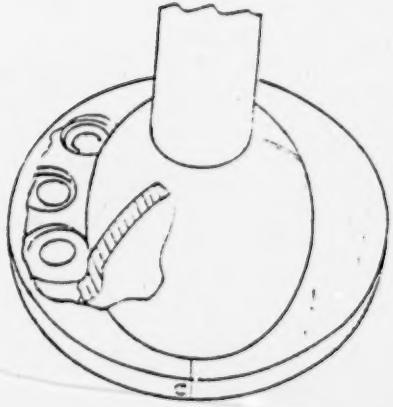
AMERICAN ROUND BASE CENTER PEDESTAL SEAT



DETAIL OF PEDESTAL FOR PATENTED SEAT



DETAIL OF NATIONAL'S PEDESTAL FOR TOUR COACH SEAT



DETAIL OF AMERICAN ROUND BASE PEDESTAL AND COVER

000040

The facts are not complicated. A policeman observed appellant walk up to a locked Toyota, remove a plywood panel from the vent window, and enter the automobile. Three policemen subsequently found appellant in the car and pulled him out. They found a pair of sunglasses, belonging to the owner of the car, in Jimenez's hip pocket. At trial, appellant tried to establish, through his own testimony, that he had not intended to burglarize the car but had merely been seeking refuge from some men who had beaten him up in a fight earlier that evening. On cross-examination the prosecutor asked appellant if he had ever been "convicted of stealing," but never introduced any evidence of prior convictions.

On appeal appellant argues first that the trial judge should have made a preliminary determination that the probative value of this evidence outweighed its prejudicial effect. Second, he claims that the prosecutor, by referring to prior convictions without proving that they were felonies, offered misleading and incomplete evidence. Finally, appellant insists that this Court may consider both of these alleged errors even though his trial counsel made no objection.[2]

Since appellant's case was tried before a Judge, we do not have to determine whether this evidence was admissible. As we stated in *United States v. Impson*, 5 Cir., 1977, 562 F.2d 970,

> [a] judge, sitting as a trier of fact, is presumed to have rested his verdict only on the admissible evidence before him and to have disregarded that which is inadmissible. *United States v. Masri*, 547 F.2d 932, 936 (5 Cir. 1977); *United States v. Dillon*, 436 F.2d 1093, 1095 (5 Cir. 1971). Any error is thus harmless if there exists other admissible evidence sufficient to support the conviction.

Having examined the record, we are convinced that there is sufficient clearly admissible evidence to support appellant's conviction. He committed the acts proscribed by C.Z.C. §§ 502 503. The trial judge, whose job it is to pass on the credibility of witnesses, *United States v. Impson, supra* at 971, apparently did not believe that defendant lacked *mens rea*. The conviction is therefore affirmed.

AFFIRMED.

2. Appellant argues that these errors were so prejudicial that they constituted "plain error."

Anne D. NICKOLA, Plaintiff-Appellant,

v.

Kenneth PETERSON, d/b/a Kaydee Products Company, Defendant-Appellee.

No. 76-1916.

United States Court of Appeals, Sixth Circuit.

Argued Nov. 30, 1977.

Decided June 23, 1978.

Rehearing and Rehearing En Banc Denied Oct. 27, 1978.

Action was brought for patent infringement and for wrongful use of trade secrets. The United States District Court for the Eastern District of Michigan, Southern Division, James Harvey, J., 410 F.Supp. 590, after jury verdict for plaintiff on patent count, granted defendant's motion for judgment notwithstanding the verdict, declared patent claims invalid and entered judgment for defendant, and plaintiff appealed. The Court of Appeals, Markey, Chief Judge, sitting by designation, held that: (1) claims 4 and 21 of Reissue patent No. 27,400 relating to invention which was intended to furnish gas and electric service to individual mobile homes and which consisted of combination of upright post with electric power box, electric meter and gas meter mounted on post, were not invalid for lack of novelty, but (2) claims would have been obvious at time of invention to person having ordinary skill in the art and were therefore invalid for obviousness.

Affirmed.

1. Patents ⇐112.1

Statutory presumption of validity of patent is merely rule of evidence that requires defendant to prove, by clear and convincing evidence, invalidity of patent in an infringement action. 35 U.S.C.A. § 282.

2. Patents ⇐37

Statutory section which is general statement of what may be patented does not specify conditions for patentability and "requirements" broadly referred to in such section, including requirement for "novelty," are set forth elsewhere, and thus, with term carefully spelled out in next section, no warrant exists for looking to broad, undefined word "new" in general section for understanding or application of novelty requirement. 35 U.S.C.A. §§ 101, 102.

3. Patents ⇐45

No-evidence-of-novelty finding could not stand in absence of record evidence that identical invention, i. e., precise combination of structural elements recited in each claim, was known or used by others in country before invention thereof by plaintiff or that identical invention recited in each claim was in public use or on sale in country more than one year prior to date of her application. 35 U.S.C.A. § 102(a, b).

4. Patents ⇐328(4)

Claims No. 4 and 21 of Reissue patent No. 27,400 describing a combination of a pole, electric meter, electric power box, and a gas meter, providing complete utility service for individual mobile homes and trailers, were not invalid for lack of novelty. 35 U.S.C.A. § 102.

5. Patents ⇐18

Exercise of judicial process in determining whether an invention has met nonobviousness requirement turns on application of entire statutory provision to all relevant evidence of record. 35 U.S.C.A. § 103.

6. Patents ⇐18, 41

Lack of cooperation, like result achieved or function performed, is not material on issue of novelty of invention, though it may be material on issue of nonobviousness, and thus to conclude that a combination lacks novelty because its elements don't cooperate is to find novelty lacking without regard to the prior art, and is improper under applicable statute. 35 U.S.C.A. §§ 102, 103.

7. Patents ⇐18

Issue of obviousness-nonobviousness of invention is ultimately determined as conclusion of law, involving as it does consideration of the subject matter of invention as a whole and consideration of a legal ghost called a "person having ordinary skill in the art" while novelty and utility, on the other hand, are determinable as issues of fact. 35 U.S.C.A. §§ 102, 103.

8. Patents ⇐18

Obviousness of patent intended to furnish gas and electric service to individual mobile homes was a question of law. 35 U.S.C.A. § 103.

9. Patents ⇐328(4)

Inventions recited in claims 4 and 21 of Reissue patent No. 27,400 relating to combination of upright post, electric power box, electric meter and gas meter mounted on post, intended to furnish gas and electric service to individual mobile homes, would have been obvious at time inventions were made to person having ordinary skill in the art and were therefore invalid for obviousness. 35 U.S.C.A. § 103.

Charles W. Chandler, Gifford, Chandler, Sheridan & Sprinkle, Birmingham, Mich., for plaintiff-appellant.

John K. McCulloch, Saginaw, Mich., for defendant-appellee.

Before CELEBREZZE, Circuit Judge, LIVELY, Circuit Judge, and MARKEY, Chief Judge of the U. S. Court of Customs and Patent Appeals.*

MARKEY, Chief Judge, Court of Customs and Patent Appeals.

Appeal under 28 U.S.C. § 1291 by plaintiff-patentee, Anne D. Nickola (Nickola), from the district court's patent invalidity decision after a six-day jury trial.[1] The complaint against defendant, Kenneth Peterson d/b/a Kaydee Products Company (Peterson), contains count I, alleging infringement of claims 4 and 21 in Nickola's patent,[2] and count II, alleging wrongful use of trade secrets. In a special verdict of fifteen interrogatories, the jury found for Nickola on the patent count and determined her damages as $6,230.00. On the trade secret count, the jury returned a general verdict for Peterson. The district court then granted Peterson's motion for judgment notwithstanding the verdict on the patent count, denied his alternative motion for a new trial, set aside part of the special verdict, declared the two patent claims invalid, and entered judgment for Peterson on both counts. Nickola appeals only the patent invalidity decision. We affirm.

The Invention

The invention, intended to furnish gas and electric service to individual mobile homes, is the combination of an upright post, with an electric power box, an electric meter, and a heating fuel meter (e. g., a gas meter) mounted on the post.

Fig. 2 in Nickola's patent is reproduced here:

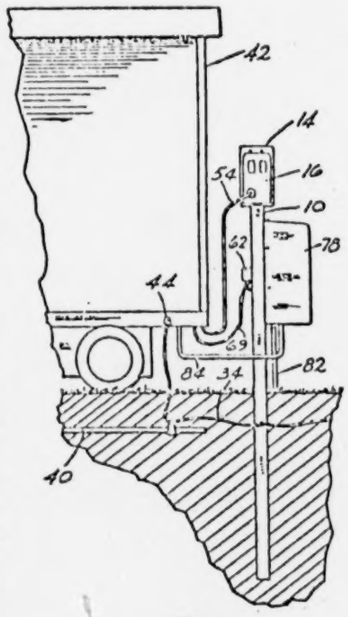


FIG. 2

Referring to Fig. 2, the patent describes a mobile home 42, an elongated post 10, "conventional" electric meter 14, "conventional" electric power box 16, electric cable 54 connecting the power box to the mobile home, ground wire 34 connecting "conventional" mobile home ground wire connection 44 to "conventional" underground metal water pipe 40, "conventional" gas meter 78, "conventional" gas pipes 82 and 84, "conventional" telephone box 62, and "conventional" telephone cable 69.

* Honorable Howard T. Markey sitting by designation.

1. 410 F.Supp. 590, 193 USPQ 443 (E.D.Mich. 1976).

2. Reissue Patent No. 27,400, for "Mounting Pedestal For Utilities," granted June 20, 1972 reissuing Patent No. 3,502,785, granted March 24, 1970 on an application filed November 20, 1967.

Claim 4 recites a combination of four structural elements:

"4. [1] An elongated post mounted in an upright position,
[2] an electrical meter and
[3] an electrical power box mounted on the upper end of said post on opposite sides thereof, [and]
[4] a heating fuel metering means mounted to said electrical meter and said electrical power box."
[Bracketed matter and paragraphing added.]

Claim 21 recites a combination of six structural elements:

"21. [1] An elongated post mounted in an upright position,
[2] an electrical meter and
[3] an electrical power box mounted to said post,
[4] electrical wires extending upwardly along said post and electrically connected to said meter,
[5] an electrical wire connected to and extending from said power box, and
[6] a heating fuel metering means mounted to said post."
[Bracketed matter and paragraphing added.]

Nickola's company, Adnic Products Co., sells a metal post 8 ft. in length, with an L-shaped mounting plate on one end, bearing the trademark POWER PACK PEDESTAL. The post and an electric power box are sold as a unit.

The buyer (e. g., a mobile home park operator) installs the unit in an upright position by burying approximately half of the post in the ground at a mobile home site. The local utility company provides underground gas and electric service to the post, and also provides and mounts the gas and electric meters on the post.

The Trial Testimony

Trial was in November, 1975. Nickola, who demanded a jury trial,[3] testified, so far as material here:

That she was manager of a mobile home park; that in about 1960 electric meters for mobile homes were mounted on a "gang rack" at the rear of the park; that in 1960 mobile homes used "bottled gas"; that in about 1965, when gas service became available, the gas meters were also mounted on a gang rack at the rear of the park, with individual underground supply lines running from each gas meter to a mobile home site; that the next event was introduction of an "electrical pedestal" mounting an electric meter at each mobile home, replacing the central gang rack of electric meters; that she then "introduced the first safe pedestal that combined gas and electric."

Nickola told of a mobile home fire in about 1965, when firemen fought against "live gas and a live electric" because they had disconnected the "wrong gas" and "wrong electric" at the gang racks, and that, in conceiving her invention in May, 1966, she "put something together and worked it out where utilities could be on the same device."

Nickola said her first pedestals for gas and electric meters were approved for her park by the local utility (Consumers) and placed in service on December 18, 1967. She consulted a patent attorney, had prepared a "Record of Invention" form dated April 26, 1967, and had filed her original patent application in the Patent Office (now the Patent and Trademark Office) on November 20, 1967 (exhibit 4). She said that, with commercial sales beginning in 1968, "40 to 50,000" units had been sold.

On cross-examination, she answered that the gas meter, the electric meter, and the other devices which can be mounted on the post, each "work independently of the other."

Kenneth DeVerna, long time employee of Consumers and member of its product evaluation committee, testified that, to his knowledge, Nickola's pedestal was the first approved by his company for combined gas and electric service. John D. Gribble, an-

3. Under Fed.R.Civ.P. 38.

other Consumers employee, gave essentially the same testimony.[4]

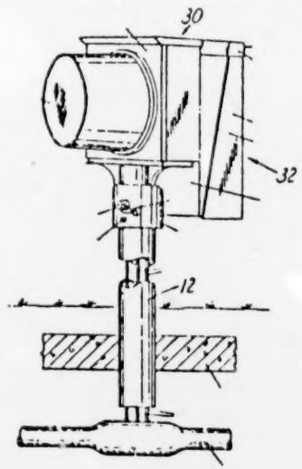
When Nickola rested, Peterson moved orally for a directed verdict on the ground that Nickola had not proved infringement. That motion being denied, Peterson testified primarily with respect to infringement and trade secrets. Peterson then presented Francis B. Boyle as "an expert in the art relating to utility pedestals."

In summary, Boyle testified that from 1962 until his retirement in 1972 he had been designing, manufacturing, and installing utility pedestals; that one of his mobile home pedestals was an elongated post mounting an electric meter and an electric power box, as shown in a photograph dated September, 1963; that in 1963 or 1964 "customers" requested him to "put a hole in there [in the post] for the mounting bracket to support a gas meter," that he designed a second utility pedestal like his first, as shown in a photograph dated June, 1966; that Consumers approved his second pedestal for mobile homes on July 8, 1966; that on the same day he visited Nickola and offered to supply his pedestals; that "in the summer of 1966," in his opinion, it would have been "obvious * * * to mount a gas meter and an electric meter and power box on the same pedestal,"[5] though he "didn't like the idea of mounting a gas meter on the same post as an electrical meter" because if "the [gas] pipe broke and there were a spark, it would ignite;" and that his second pedestal is described in U. S. Patent No. 3,450,951 (exhibit 13), for "Outdoor Electrical Meter Box and Service Outlet For Mobile Homes," granted June 17, 1969 on an application filed July 12, 1967.[6]

In rebuttal, Nickola gave her opinion that it would not have been obvious in May, 1966 (her conception date) "to combine both a gas meter and an electric meter on the same post" because gas "was just newly introduced," "there was a lot of opposition," and "people dislike the gas and electric on the same thing because of fires and dangers of that sort." She further stated that Boyle's visit to her occurred in September, 1968 (not on July 8, 1966).

Motions After The Close of Evidence

[1] Peterson again moved orally for a directed verdict on the ground that Nickola had not proved infringement. That motion was denied. Nickola then moved orally for a directed verdict of patent validity, on the ground that Peterson had not overcome the



4. Nickola presented additional exhibits and seven more witnesses. Discussion of that evidence, directed primarily to infringement, damages, and trade secrets, is unnecessary.

5. Nickola's counsel objected to the question which prompted this testimony on the ground that it called for "the ultimate legal conclusion for the Court to make." The district court correctly overruled the objection, citing Fed.R.Evid. 704:

> "Rule 704. Opinion on Ultimate Issue
>
> "Testimony in the form of an opinion or inference otherwise admissible is not objectionable because it embraces an ultimate issue to be decided by the trier of fact."

6. Boyle's patent, cited without objection as prior art by the patent examiner in Nickola's reissue application, depicts in Fig. 1 an electric meter 30 and electric power box 32 mounted on vertical post 12 (other reference numbers deleted).

statutory presumption of validity,[7] and arguing that there had been "no evidence to go to the jury to challenge the validity of the patent under Sec. 102[8] of the Patent Act, the novelty requirement," nor "any competent testimony to go to the jury to challenge the validity of the patent under Sec. 103."[9] In opposition, Peterson argued that the patent was invalid because "the combination of the elements such as electric power boxes and meters and gas meters is really an aggravation [sic, aggregation] of elements * * *, they have no other function among themselves or one upon the other" and because "the mounting of a gas meter on a pedestal which already supports an electric meter and a power box is obvious and was obvious at the time plaintiff made her invention, whenever she made her invention."

The district court denied Nickola's motion for a directed verdict, stating "there are issues of fact to go to the jury as to the validity of the patent."

Aware that the trial judge intended to treat validity as a question of law, after submitting interrogatories to the jury, Nickola moved orally to submit the "issue of validity itself" to the jury because it "can be tried by the jury" under Fed.R.Civ.P. 38. In denying this motion, the district court observed that "it was held," in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966), "the question of patent validity is one of law."

7. 35 U.S.C. § 282 (1970) provides in part:

> "§ 282. Presumption of validity; defenses.
>
> "A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it."

The district court correctly stated, in its jury instructions, that the presumption is "merely a rule of evidence that requires the defendant to prove by clear and convincing evidence" the invalidity of the patent. Like other legal presumptions, that provided for in 35 U.S.C. § 282 merely assigns the burden of proof, as the last (and for that purpose redundant) sentence of the provision makes clear.

8. 35 U.S.C. § 102 (1970) provides:

> "§ 102. Conditions for patentability; novelty and loss of right to patent.
>
> "A person shall be entitled to a patent unless—
>
> "(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> "(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
>
> "(c) he has abandoned the invention, or
>
> "(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or
>
> "(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or
>
> "(f) he did not himself invent the subject matter sought to be patented, or
>
> "(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

9. 35 U.S.C. § 103 (1970) provides:

> "§ 103. Conditions for patentability; non-obvious subject matter.
>
> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

The Special Verdict

Of the fifteen interrogatories answered by the jury in its special verdict,[10] these six are material here:

"Interrogatory No. 1

Is plaintiff's claimed invention 'different' from the prior art by its combining an electric power box and an electric meter on an upright elongated post with a fuel metering means, such as a gas meter, as stated in claim no. 4 of Nickola reissue patent no. 27,400?

Answer 'yes' or 'no'. Answer: *Yes*"

"Interrogatory No. 2

Does the combination of a fuel metering means, such as a gas meter, with an electric meter box, and electric power box, and an elongated pole, as stated in claim no. 4 of Nickola reissue patent no. 27,400, produce a combined result other than the result produced by a fuel metering means, an electric power box, an electric meter, and an elongated pole operating separately?

Answer 'yes' or 'no'. Answer: *Yes*"

"Interrogatory No. 3

Would a person or ordinary skill in the utility meter and power box mounting art at the time of the claimed invention have found the combined result of a fuel metering means, an electric power box, electric meter and an elongated pole, as stated in claim no. 4 of Nickola reissue patent no. 27,400, to be unusual and unexpected?

Answer 'yes' or 'no'. Answer: *Yes*"

"Interrogatory No. 4

Is plaintiff's claimed invention 'different' from the prior art by its combining electrical wiring, some of which runs upwardly along the upright pole and electrically connects to the electric meter, and some of which is connected to and extends from the power box, with the electric meter, electric power box, and fuel metering means as set forth in claim no. 21 of Nickola reissue patent no. 27,400?

Answer 'yes' or 'no'. Answer: *Yes*"

"Interrogatory No. 5

Does the combination of an electric meter and an electric power box with associated electrical wiring, a post, and a heating fuel metering means as set forth in claim no. 21 of reissue patent no. 27,400 produce a combined result differing from the results produced by the electric meter and power box with associated wiring, a post, and a heating fuel metering means operating separately?

Answer 'yes' or 'no'. Answer: *Yes*"

"Interrogatory No. 6

Would a person of ordinary skill in the utility meter and power box mounting art at the time of the claimed invention have found the combined result of electric wiring, a fuel metering means, an electric power box, electric meter box, and an elongated pole, as stated in claim No. 21 of Nickola reissue patent no. 27,400, to be unusual and unexpected?

Answer 'yes' or 'no'. Answer: *Yes*"[11]

Motion For Judgment Notwithstanding The Verdict

Peterson filed a written motion for judgment notwithstanding the verdict,[12] or alternatively for a new trial, accompanied by an extensive memorandum asserting "invalidity, as a matter of law."

The District Court

With its order granting Peterson's motion for judgment n. o. v., denying the alternative motion for new trial, setting aside the jury's answers to interrogatories 2, 3, 5, and 6 (and 15, setting damages at $6,230.00), declaring the two patent claims invalid, and entering judgment for Peterson, the district court filed an opinion containing:

[1]

"In order to be patentable, any claimed invention must satisfy the requirement of

10. See Fed.R.Civ.P. 49(a)

11. The jury was not asked at any point to define or describe the "combined result" referred to in interrogatories 2, 3, 5, and 6, nor was the jury asked to answer "yes" or "no" to any question spelling out a specific "combined result."

12. Under Fed.R.Civ.P. 50(b).

'novelty.' This requirement is the *sine qua non* of patentability. 35 U.S.C. § 101.[13] Since plaintiff does not claim to have invented either the gas meter, the electric meter, or the electric power box, but claims to have invented the combination of those elements in her Power Pack Pedestal, the element of novelty if such there is must reside in the combination of those elements. *Anderson's Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d 258 (1969)." [410 F.Supp. at 593, 193 USPQ at 445.]

[2]

"The issue of novelty was submitted to the jury in interrogatories numbers 2 and 5. The jury by answering 'yes' to each found that patent claim no. (4) and patent claim (21) both satisfied the novelty requirement. In viewing the evidence in the light most favorable to plaintiff, and drawing all reasonable inferences in her favor, the Court finds the conclusions of the jury to be unwarranted.

"Although a patent is presumptively valid, this presumption has no independent evidentiary weight. *Sperberg v. Goodyear Tire & Rubber Co.*, 519 F.2d 708 (CA 6, 1975) [*cert. denied*, 423 U.S. 987, 96 S.Ct. 395, 46 L.Ed.2d 303 (1975)]. Since the Court finds no evidence from which a jury could reasonably conclude that the novelty requirement of 35 U.S.C. § 101 was satisfied and substantial evidence that it was not satisfied, defendant's motion for judgment notwithstanding the verdict will be granted. *Gillham v. Admiral Corp.*, 523 F.2d 102 (CA 6, 1975) [*cert. denied*, 424 U.S. 913, 96 S.Ct. 1113, 47 L.Ed.2d 318 (1976)]." [*Id.* at 593-94, 193 USPQ at 445-46.]

[3]

"Likewise, this Circuit has recently restated the rule that every element of a combination invention must cooperate to produce a new result in order for there to be novelty within the meaning of 35 U.S.C. § 103. *Phillips Industries, Inc. & Mobil Temp, Inc. v. State Stove & Manufacturing Co., Inc.* [522 F.2d 1137 (6th Cir. 1975)]. The uncontroverted evidence before the Court is that there is no cooperation between the elements in plaintiff's claimed invention and that no cooperative result is produced other than the sum of the independent functions of those elements. Accordingly, the patent claims in issue will be held invalid for lack of novelty. 35 U.S.C. § 101." [*Id.* at 595, 193 USPQ at 446-47.]

[4]

"Whether persons of ordinary skill in the art disagree as to the safety of a product or techniques does not determine the issue of obviousness. The issue regarding obviousness is whether the differences embodied in a combination product and the result so produced would have been non-obvious to a person of ordinary skill in the art, not whether there was a controversy over whether such was safe. *In re Jansen*, 525 F.2d 1059 [, 187 USPQ 743] (Cust. & Pat.App., 1975) [, *cert. denied*, 425 U.S. 972, 96 S.Ct. 2170, 48 L.Ed.2d 796 (1976)]." [*Id.* at 596, 193 USPQ at 447.]

[5]

"Since the Court finds no evidence on which a finding of non-obviousness could be based, the Court will grant defendant's motion for judgment notwithstanding the verdict on interrogatories number (3) and number (6). In these interrogatories, the jury had answered that a person of ordinary skill in the art would have considered the result produced by the claimed combination inventions to be unusual and surprising." [*Id.*, 193 USPQ at 448.]

[6]

"In sum, the Court finds contrary to the determinations of the jury that the patent claims at issue are invalid both for lack of novelty and because of obviousness. Although the Court is reluctant to

13. 35 U.S.C. § 101 (1970) provides:

"§ 101. Inventions patentable

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

set aside the determinations of a jury, the Court recognizes that patent validity is primarily a question of law. *Dickstein v. Seventy Corp.*, 522 F.2d 1294 (CA 6, 1975) [*cert. denied*, 423 U.S. 1055, 96 S.Ct. 787, 46 L.Ed.2d 644 (1976)]; *Monroe Auto Equipment Co. v. Heckethorn Manufacturing & Supply Co.*, 332 F.2d 406, 411 (CA 6, 1964) [*cert. denied*, 379 U.S. 888, 85 S.Ct. 160, 13 L.Ed.2d 93 (1964)]. In determining the issue of validity, the Court is bound to scrutinize patented combinations of old elements with special care due to the improbability of finding a patentable invention in an assembly of old elements, *Phillips Industries, Inc. & Mobil Temp., Inc., v. State Stove & Manufacturing Co., Inc.*, 522 F.2d 1137 (CA 6, 1975); and because of the 'blight' on free commerce which is imposed by an invalid patent. *Hieger v. Ford Motor Co.*, 516 F.2d 1324 (CA 6, 1975) [*cert. denied*, 423 U.S. 1056, 96 S.Ct. 788, 46 L.Ed.2d 645 (1976)]." [*Id.* at 596 97, 193 USPQ at 448.]

The Issue

The dispositive issue is whether the district court erred in granting Peterson's motion for judgment n. o. v.

OPINION

I. Statutory Basis of the Novelty Requirement

[2] The statement that 35 U.S.C. § 101, *supra* note 13, sets forth the "novelty requirement" for patentability was in error. That section does employ the term "new," a synonym for "novel." Section 101, however, is a general statement of what may be patented ("process, • • • improvement thereof"). The words "new" and "useful," appearing twice, merely indicate the broad concept that a patent may not be obtained on that which is old or useless. Section 101 does not specify the conditions for patentability. The "requirements" (conditions) broadly referred to in § 101, including the requirement for "novelty," are set forth elsewhere in the statute.[14]

Congress accomplished the task of defining "new," i. e., of setting forth the "novelty requirement," in the succeeding section, 35 U.S.C. § 102, *supra* note 8, entitled "*Conditions* for patentability, *novelty* and loss of right to patent." (Emphasis added.) Thus, as the Ninth Circuit stated in *Reeves Instrument Corp. v. Beckman Instruments, Inc.*, 444 F.2d 263, 270, *cert. denied*, 404 U.S. 951, 92 S.Ct. 283, 30 L.Ed.2d 268 (1971), "[t]he requirement of novelty is more specifically defined in 35 U.S.C. § 102 • • •." With the term carefully spelled out by Congress in § 102, no warrant exists for looking to the broad, undefined word "new" in § 101 for understanding or application of the novelty requirement. There being a clear statutory base for the novelty requirement in § 102, judicial application of the novelty requirement should focus on that specific provision.[15]

14. Patent cases being relatively infrequent, comments of potential applicability may be found in "Judges' Primer Patent and Copyright Law and Procedure" in Part VIII of *Seminars For Newly Appointed U.S. District Judges* (1970 71, Federal Judicial Center, Washington, D. C.), and "Special Problems in Patent Cases," 66 F.R.D. 529 (1975) (reprinted in 57 J.Pat.Off. Soc'y 675 (1975)) presented at the Federal Judicial Center, October 16, 1974. For discussion of jury trials in patent cases, see Ropski, *Constitutional and Procedural Aspects of the Use of Juries in Patent Litigation* (pts. I II), 58 J.Pat.Off.Soc'y 669, 673 (1976).

15. "The novelty required is not novelty in an absolute sense, as the statute defines what is to be looked to in order to show that an invention is not new." Federico, "Commentary On The New Patent Act [of 1952]" in 35 U.S.C.A. p. 1, at p. 17 (1954). Thus, prior public knowledge or use in a foreign country would destroy novelty if the novelty requirement resided merely in the word "new" in the absolute sense in which it appears in § 101, whereas Congress has provided in § 102 that such foreign circumstances do not destroy novelty under the statute. Similarly, under proper circumstances, a person may be entitled to a patent, even though that person was not the first to make the invention. *See, e. g., Howarth v. Lee*, 564 F.2d 948, 195 USPQ 701 (Cust. & Pat.App.1977) (first inventor suppressed or concealed the invention, therefore, second inventor entitled to priority under 35 U.S.C. § 102(g)).

Legislative history is in accord. S.Rep. No.1979, 82nd Cong., 2d Sess. (1952) states at p. 5, U.S.Code Cong. & Admin.News 1952, pp. 2394, 2399,

> "Section 101 sets forth the subject matter that can be patented, 'subject to the conditions and requirements of this title.' The conditions under which a patent may be obtained follow, and *section 102 covers the conditions relating to novelty.*" [Emphasis added.]

then at p. 6, U.S.Code Cong. & Admin.News 1952, p. 2399,

> "*Section 102, in general, may be said to describe the statutory novelty required for patentability, and includes, in effect, an amplification and definition of 'new' in section 101.*" [*Emphasis added.*]

and finally at p. 17, U.S.Code Cong. & Admin.News 1952, p. 2409 in the "Revision Notes,"

> "The corresponding section of existing statute is split into two sections, section 101 relating to the subject matter for which patents may be obtained, and *section 102 defining statutory novelty* and stating other conditions for patentability." [Emphasis added.]

Statements identical to the foregoing appear in H.R.Rep.No.1923, 82nd Cong., 2d Sess. (1952) at pp. 6, 7, and 17, respectively.

As stated in *In re Bergstrom*, 427 F.2d 1394, 1401, 57 CCPA 1210, 1249, 166 USPQ 256, 262 (1970):

> "[T]he criteria for determining whether given subject matter is 'new' within the meaning of § 101 are no different than the criteria for determining whether that subject matter possesses the 'novelty' expressed in the title of § 102. The word 'new' in § 101 is defined and is to be construed in accordance with the provisions of § 102. Thus, that which possesses statutory novelty under the provisions of § 102 is also new within the intendment of § 101. We have found no evidence of Congressional intent to define the word 'new' as used in § 101 in any different manner." [Footnote omitted.]

II. Peterson Did Not Carry His Burden of Proving Lack of Novelty

Considering the finding of "no evidence from which a jury could reasonably conclude that the novelty requirement • • • was satisfied and substantial evidence that it was not satisfied" (410 F.Supp. at 594, 193 USPQ at 446) inconsistent with the jury's answers to interrogatories 2 and 5, *supra*, the court set those answers aside.

[3] The no-evidence-of-novelty finding cannot stand in the absence of record evidence: (1) that the identical invention, i. e., the precise *combination* of structural elements recited in each claim, "was known or used by others in this country • • • before the invention thereof by [Nickola]" (§ 102(a)); or (2) that the identical invention recited in each claim was "in public use or on sale in this country, more than one year prior to the date of [Nickola's] application" (§ 102(b)).[16] No such evidence is of record.

[4] The "substantial evidence," referred to as defeating novelty, was not specified. Peterson's only evidence touching novelty was Boyle's testimony that "customers" had requested him to make holes for a gas meter bracket in some of his electric meter pedestals. Boyle did not testify that he had ever seen a gas meter so mounted. There was no evidence that any customer had actually mounted a gas meter on a Boyle pedestal and no evidence that the utility company had given the required approval for any such mounting. There was thus no evidence that gas meters had been mounted on electric meter pedestals before Nickola's invention, i. e., that Nickola's *combination* was old. Peterson's evidence to show lack of novelty was thus wholly inadequate to meet his burden under § 102.

Peterson having failed to meet his burden, evidence of novelty was unnecessary. 35 U.S.C. § 282, *supra* note 7. Nonetheless, Nickola's utility witnesses testified without challenge that Consumers had not approved a combination gas and electric pedestal be-

16. The other subsections of § 102 have no application to the facts of this case.

fore approving Nickola's in December, 1967. Were it necessary to evaluate the evidence, therefore, the novelty of Nickola's particular claimed combination would appear unquestionably established.

In all events, novelty is a question of fact, as discussed below, and it is clear that the evidence touching upon novelty, such as it was, was sufficient to have been submitted to the jury. Under such circumstances, a conclusion that no reasonable juror could have found the inventions recited in claims 4 and 21 to have been novel constitutes an error of law.

III. New Result v. Novelty

Though the jury's answers to interrogatories 2 and 5 were set aside, on the theory that they were inconsistent with a lack of novelty finding, 2 and 5 were not the material interrogatories on the novelty issue. Those interrogatories were directed to a different question—whether the inventions "produce a combined result" other than (interrogatory 2), or differing from (interrogatory 5), "the result produced by [the individual structural elements] operating separately." Thus, interrogatories 2 and 5 are concerned with the overall *function* or *operation* of the combination of individual structural elements, not with the novelty of the combination itself.

The function of the combination can be material, not on the novelty issue, but on the separate and distinct issue of nonobviousness (35 U.S.C. § 103, *supra* note 9).

The view that "novelty" was covered in interrogatories numbers 2 and 5 and that there must be "a new result in order for there to be novelty within the meaning of 35 U.S.C. § 103",[17] intermixed the question of novelty (whether the particular *combination* claimed had existed before Nickola made it) with one of the indicia (a "new" or "unexpected" result) sometimes useful in determining the entirely different question of nonobviousness. The distinction is important, for patent law is entirely statutory and there is not a word in the statute requiring a new result or a new function as a condition of patentability. Indeed, a requirement that the result must itself be novel would nullify the statutory provision encouraging disclosures of "new and useful improvements thereof." 35 U.S.C. § 101.

Most patents are granted on improvements of prior devices;[18] and the improved device will inherently achieve the same basic result as that achieved, and will perform the same basic function as that performed, by the prior device. An improved jet engine, for example, necessarily achieves the same result and performs the same function—propulsion—as that achieved by prior jet engines, yet it may constitute a "new and useful improvement" entitled to the protection provided by our patent laws, 35 U.S.C. § 101, as an incentive to make and disclose improvements in prior devices. Similarly, the result achieved by the horse, the automobile, and the airplane is the same—transportation. Only the speed of achievement varies. Yet it may be supposed that one unaware of the statute and its constitutional background would recognize the airplane as a patentable improvement over the horse and the automobile. To require in every case that a new "function" or new "result" be performed or achieved, would be destructive of "the progress of * * * useful arts" goals sought in the constitutional-statutory scheme.

The interrogatories relating to novelty were numbers 1 and 4, which were not

17. The opinion below includes the statement that "this Circuit has recently restated the rule that every element of a combination invention must cooperate to produce a new result in order for there to be *novelty* within the meaning of 35 U.S.C. 103" (410 F.Supp. at 595, 193 USPQ at 446-47, emphasis added), citing *Philips Industries Inc. v. State Stove & Manufacturing Co., Inc.*, *supra*. *Philips Industries* involved no question of novelty in the combination claimed.

18. In *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 368, 58 S.Ct. 899, 901, 82 L.Ed. 1402 (1938), the Court noted congressional recognition that "most inventions represent improvements on some existing article, process or machine. * * *" More than 70,000 patents are currently issued each year. *Commissioner of Patents and Trademarks Annual Report, Fiscal Year 1976* (1977).

disturbed. Those interrogatories inquired whether the inventions were "different" from the prior art, i. e., whether Nickola's combination was "novel" in the statutory sense.[19] 35 U.S.C. § 102. The jury answered "yes"; and in the absence of record evidence indicating the presence of the claimed combination in the prior art, that answer was correct.

[5] Though it was error to hold Nickola's patent claims invalid for lack of novelty, the district court did not err in its grant of judgment n. o. v., for novelty alone will not render an invention patentable. Some new and useful inventions are patentable. Some are not. To be patentable a new and useful invention must meet the third requirement—nonobviousness—set forth in 35 U.S.C. § 103.[20]

IV. Nonobviousness v. Novelty

Confusion of the novelty requirement defined in § 102 with the nonobvious subject matter requirement defined in § 103 is avoided when the statutory sections are applied in proper sequence. The starting point in applying § 103 is the recognition that the claimed invention—the claimed subject matter as a whole—is novel under § 102. If the claimed subject matter be old, consideration of § 103 is unnecessary. The first clause of § 103 states that: "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title." The heart of § 103 then follows, "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

Though, early on, the opinion below correctly stated, "novelty if such there is must reside in the combination of those elements," (410 F.Supp. at 593, 193 USPQ 445) citing *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d 258 (1969), it later stated, incorrectly, that "the determination of novelty for combination inventions does not turn on whether the old elements are arranged in a new manner which serves some useful function but on whether the function produced by that arrangement is itself new." (410 F.Supp. at 595, 193 USPQ at 446.) As above stated, a requirement for a

19. "[A] device lacks novelty if there is, or has been, a substantially identical prior device." *Monroe Auto Equip. Co. v. Heckethorn Mfg. Co.*, 332 F.2d 406, 414 (6th Cir.), *cert. denied*, 379 U.S. 888, 85 S.Ct. 160, 13 L.Ed.2d 93 (1964).

20. There is no requirement that a court find "invention" present. The difficulty experienced by courts in defining that amorphous, ephemeral, indefinable label was noted by the Court in *Graham v. John Deere Co.*, 383 U.S. 1, 11-12, 86 S.Ct. 684, 690, 15 L.Ed.2d 545 (1966):

> "The language in the case [*Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 267, 13 L.Ed. 684 (1850)], and in those which followed, gave birth to 'invention' as a word of legal art signifying patentable inventions. Yet, as this Court has observed, '[t]he truth is the word [invention] cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not.' *McClain v. Ortmayer*, 141 U.S. 419, 427, 12 S.Ct. 76, 78, 35 L.Ed. 800 (1891). *A & P Tea Co. v. Supermarket Corp.* [340 U.S. 147] at 151, 71 S.Ct. 127 at 129, 95 L.Ed. 162. Its use as a label brought about a large variety of opinions as to its meaning both in the Patent Office, in the courts, and at the bar." That difficulty led Congress, 26 years ago, Patent Act of 1952, 66 Stat. 792 (enacting Title 35, U.S.Code), to specify nonobviousness of the subject matter as a whole to one skilled in the art at the time the invention was made as the "new statutory formulation" (*John Deere, Id.* 383 U.S. at 12, 86 S.Ct. 684) of the third requirement for patentability. Congress further mandated that "invention" should henceforth refer to the "invention or discovery" (35 U.S.C. § 100(a)), i. e., the *thing* invented or discovered. Difficulties since 1952 have centered on inapt references to old cases calling on courts to find "invention," and on judicial efforts to supply semantic mechanisms as aids in defining "obviousness." Because inventions differ so widely, application of all such mechanisms to all inventions, as rules of law, would risk destruction of the entire statutory scheme. See note 22, *infra*. Exercise of the judicial process, in determining whether an invention has met the nonobviousness requirement, turns on application of the entire statutory provision, 35 U.S.C. § 103, to all relevant evidence of record.

new function would nullify the statutory provision for patenting "improvements" which necessarily perform the old function of the now-improved device.

As authority for the view that a new function must be found, the opinion below quoted this part of the opinion in *Anderson's-Black Rock*, *supra*, 396 U.S. at 62, 90 S.Ct. at 308:

> "We conclude that while the combination of old elements performed a useful function,[4] it added nothing to the nature and quality of the radiant-heat burner already patented
>
> [4] 35 U.S.C. § 101 provides:
>
> "'Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.'
>
> "Absent here is the element 'new.' For as we have said, the combination patent added nothing to the inherent characteristics or function of the radiant heat burner."

The sole issue in *Anderson's-Black Rock* was nonobviousness, not novelty. The Court stated that "[i]n this case the question of patentability of the combination turns on the meaning of 35 U.S.C. § 103 which the court reviewed in the *Graham* [*v. John Deere Co.*] case [383 U.S. 1], at 13-17, 86 S.Ct. [684] 691-693 [15 L.Ed.2d 545] [1966]," (396 U.S. at 61-62, 90 S.Ct. at 308, footnote omitted) and "[w]e conclude that the combination was reasonably obvious to one with ordinary skill in the art" (*Id.* at 60, 90 S.Ct. at 307).

The patentee-respondent in *Anderson's-Black Rock* had argued, as evidence of nonobviousness, that its invention "involves a combination of prior art which produces the new and useful *result* [emphasis added] of eliminating the cold joint" in asphalt pavements. (*Id.* at 59, 90 S.Ct. at 307.) The patentee was arguing that the *combination* of structural elements, when operating in the intended way, produced an unexpected result, and that this was evidence of nonobviousness of the combination.

The quote from *Anderson's-Black Rock* in the opinion below related entirely to one element, the radiant-heat burner, not to the claimed combination. In footnote 4, the Court merely stated that the combination added nothing to the function of the radiant-heat burner element. Whatever relevance an added function of the *burner* may or may not have had to determination of obviousness in the combination, the Court was not saying that the total *combination* of structural elements lacked "novelty." Nor was the Court destroying the § 101 provision for "improvements" by substituting its own rule of law, i. e., by adding to the statute a requirement that an invention must perform a new function as a condition of patentability.

The findings below, that "there is no cooperation between the elements in plaintiff's claimed invention" and that "no cooperative result is produced other than the sum of the independent functions of those elements," (410 F.Supp. at 595, 193 USPQ at 447), were cited as a second ground for holding the claims invalid "for lack of novelty." Nickola admitted that no "cooperation" occurs between the individual structural elements, and that no "cooperative result" is produced; but those facts do not support a holding that the claims are invalid "for lack of novelty."

[6] Lack of cooperation, like the result achieved or function performed, is not material on the issue of novelty, though it may be material on the issue of nonobviousness. The elements needn't "cooperate," or produce a "cooperative result," for the combination *per se* to be novel. To conclude that a combination lacks novelty because its elements don't cooperate is to find novelty lacking without regard to the prior art, and is improper under the statute. *Cf. Reeves Instrument Corp. v. Beckman Instruments, Inc.*, *supra*, 444 F.2d at 270.

[7] The issues of novelty and nonobviousness differ in another regard. As appears below, the issue of obviousness-nonobviousness is ultimately determined as a conclusion of law, involving as it does, consideration of the subject matter of invention as a whole (sometimes including the result achieved and function performed as part of the "whole"), and consideration of a legal ghost called "a person having ordinary skill in the art" (like the "reasonable man" ghost in negligence cases). Novelty and utility, on the other hand, are determinable as issues of fact. The invention is either new and useful or it is not. The amount of newness and usefulness need be only miniscule to avoid a finding of lack of novelty. That miniscule difference may or may not indicate that the invention as a whole would have been obvious, but it cannot indicate that the invention was old at the time it was made. So here, a miniscule difference, adding a gas meter, made Nickola's combination novel. On the basis of all the evidence, however, as we shall see, the combination, the subject matter as a whole of the invention, would have been obvious, as a matter of law, to a person having ordinary skill in the art.

V. Obviousness Is A Question of Law

[8] The Supreme Court settled the question in *Graham v. John Deere Co.*, *supra*, 383 U.S. at 17, 86 S.Ct. at 694, where it stated: "While the ultimate question of patent validity is one of law, *A. & P. Tea Co. v. Supermarket Corp.*, [340 U.S. 147,] at 155, 71 S.Ct. [127] at 131, [95 L.Ed. 162, 1950], the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries."

This court has consistently held obviousness an ultimate conclusion of law reviewable by an appellate court. *Dickstein v. Seventy Corp.*, 522 F.2d 1294, 1297 (6th Cir. 1975), *cert. denied*, 423 U.S. 1055, 96 S.Ct. 787, 46 L.Ed.2d 644 (1976); *Monroe Auto Equip. Co. v. Heckethorn Mfg. Co.*, 332 F.2d 406, 411 (6th Cir.), *cert. denied*, 379 U.S. 888, 85 S.Ct. 160, 13 L.Ed.2d 93 (1964).

In *Kolene Corp. v. Motor City Metal Treating, Inc.*, 440 F.2d 77, 81 (6th Cir.), *cert. denied*, 404 U.S. 886, 92 S.Ct. 203, 30 L.Ed.2d 169 (1971), the point was explained with particular reference to the *Graham v. John Deere Co.* standards for determining obviousness under § 103.

> "The question of 'obviousness' in determining patent validity is a mixed question of both fact and law. *Kaiser Industries v. McLouth Steel Corp.*, 400 F.2d 36, 41 (6th Cir.); *National Filters, Inc. v. Research Products Corp.*, 384 F.2d 516 (5th Cir.); *Hensley Equipment Co. v. Esco Corp.*, 375 F.2d 432 (9th Cir.). In ruling on that question the Supreme Court said:
>
> '(1) Under § 103, the scope and content of the prior art are to be determined;
>
> '(2) Differences between the prior art and the claims at issue are to be ascertained;
>
> '(3) And the level of ordinary skill in the pertinent art resolved.
>
> '(4) Against this background, the obviousness or nonobviousness of the subject matter is determined.
>
> '(5) Such secondary considerations [21] as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.' [Note: Clauses separated and numbered for convenience.] *Graham v. John Deere Co.*, 383 U.S. 1, 17, 86 S.Ct. 684, 694, 15 L.Ed.2d 545.
>
> "When the District Court determines items numbered 1, 2 and 3, it makes findings of fact which are binding on appeal unless the findings are clearly erroneous. Rule 52(a), Fed.R.Civ.P. It is the ultimate determination of the trial judge (item number 4 above) which is a conclusion of law with which this Court

[21] The adjective "secondary" could not have meant that determination of obviousness-nonobviousness can be made in disregard of step (5) considerations when they are present. Failure to consider all relevant evidence would be both unjust and injudicious. Moreover, when a conclusion of nonobviousness is reached at step (4) there is no need to consider step (5). Hence, if it were permissible to reach a conclusion of obviousness without consideration of the evidence in step (5), the latter would never be considered.

may disagree based on the established findings of fact. See *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Sup. Co.*, 332 F.2d 406 (6th Cir.), cert. denied, 379 U.S. 888, 85 S.Ct. 160, 13 L.Ed.2d 93."

VI. The Merits of the Nonobviousness Issue

[9] In setting aside the jury's answers to interrogatories 3 and 6, the district court correctly stated the standards for determining obviousness under 35 U.S.C. § 103 (410 F.Supp. at 595, 193 USPQ at 447):

"The standards for determining obviousness under 35 U.S.C. § 103 were established by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966), and reiterated by this Circuit in *Bolkcom v. Carborundum Co.*, 523 F.2d 492, 500 (CA 6, 1975) [cert. *denied*, 425 U.S. 951, 96 S.Ct. 1725, 48 L.Ed.2d 194 (1976)]:

> "'Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.' "[22]

On the merits of the nonobviousness issue, we agree with the following portion of the district court's opinion (410 F.Supp. at 595-96, 193 USPQ at 447):

"Applying these [*Graham v. John Deere Co.*] standards to the evidence produced at trial, the Court finds that a jury could not reasonably have concluded that either of the claimed inventions set forth in claims nos. (4) and (21) of plaintiff's Reissue Patent would have been nonobvious to a person of ordinary skill in the art. From plaintiff's testimony, it is plain that the mounting of both electric meters and gas meters on posts [i. e., in gang racks] was the established practice prior to her claimed invention. Part of the prior art was the combination of an electric meter and electric power box on one post, as was constructed by Mr. Boyle in an unpatented form since 1962, which is prior to the date of plaintiff's claimed invention. It was also common practice to mount more than one electric meter on a post, as is shown by the statements in plaintiff's original patent, no. 3,502,785, issued March 24, 1970.

"The only difference between plaintiff's claimed invention and the prior art is that plaintiff's device mounted an electric and a fuel meter with a power box on a post rather than many electric meters or just an electric meter and a power box.

"From the state of prior art it is clear that it was obvious to a person of ordinary skill in the art that a post could be made to support both a gas and an electric meter."[23]

We agree also with the district court's holding, in this particular case that obviousness did not depend on "whether there was a controversy over whether such was safe." (410 F.Supp. at 596, 193 USPQ at 447.) That is not to say, however, that a safety controversy can never constitute evidence relevant to a determination of nonobviousness.

If others had recognized the advantage and dangers in mounting both electric and gas meters on a single post at each mobile home site, but had been unable to devise a means for achieving the advantages while avoiding the dangers, and if Nickola's contribution to the progress of the useful arts had been such means, evidence of a safety controversy would have been eminently relevant to the determination of obviousness of those means. When others in the field say "it won't work," that fact is strong evidence that whatever does work would have been nonobvious. *See United States v. Adams*, 383 U.S. 39, at 44 and 52, 86 S.Ct. 708, 15 L.Ed.2d 572 (1966). The outcome might have been different here if the inventor had contributed something that unlocked a safety puzzle. If here, for example, Nickola had in some manner rendered safe a previously unsafe combination, the fact that no one thought safety achievable would be strongly probative of nonobviousness.

Here, however, no one said, "it won't work." Mounting of electric meters and boxes on a single post at mobile home sites was old and the advantages of so mounting all meters were recognized. Others thought that adding a gas meter would not be safe, not that it would not "work." Nickola merely added the gas meter, doing nothing unconventional to make the combination safe.[24] The district court recognized the presence of a similar fact pattern in *In re Jansen*, 525 F.2d 1059, 187 USPQ 743 (Cust. & Pat. App. 1975), *cert. denied*, 425 U.S. 972, 96 S.Ct. 2170, 48 L.Ed.2d 796 (1976), wherein the inventor combined vitamin B_{12} and folic acid in specific quantities, against expert opinion that the preparation would be unsafe medication. The inventor did nothing to render the combination safe, but claimed merely the combination itself, which was old except for the quantities involved. The change in quantity was held to have been obvious in view of all the evidence, and, the invention not being directed to a means achieving safety in the face of safety objections, evidence of those objections was considered non-probative. So too, evidence of a safety controversy in the present case is without probative value.

22. The last sentence of the quoted paragraph is, "As indicia of obviousness or nonobviousness, these inquiries may have relevancy."

In portion [6] of the opinion below, quoted *supra*, reference is made to "the improbability of finding a patentable invention in assembly of old elements." Because virtually every invention is an assembly of old elements, see *Reeves Instrument Corp. v. Beckman Instruments, Inc.*, *supra*, 444 F.2d at 270 n. 4; *Reiner v. I. Leon Co.*, 285 F.2d 501, 503 (2d Cir. 1960); *B. G. Corp v. Walter Kidde & Co.*, 79 F.2d 20, 21 (2d Cir. 1935), the statement cannot be universally applied without risk of destroying the patent system. Unable to create from nothing, man must use old elements, which must perform their normal individual functions. A valve must valve, an electrical capacitor must exhibit capacitance, etc.

Similarly, the opinion below elsewhere refers to "combination" inventions and to "combinations of old elements," as though the statute were to be applied differently to "combination" inventions. Court opinions referring to "combination" inventions have not clearly distinguished patentability criteria applicable to different types of inventions. The statute makes no such distinction in patentability criteria (the word "combination" appears only in 35 U.S.C. § 112, dealing with claim interpretation, and in 35 U.S.C. § 271(c), dealing with contributory infringement). From the facts in some cases, the reference to "combination" may have been intended to separate mechanical or machine inventions from chemical, electrical or process-type inventions. But the statute makes no such distinction; and chemical inventions are normally combinations of chemical elements, electrical inventions are combinations of electrical circuit elements, and process inventions are combinations of steps. No statutory warrant appears, therefore, for treating the patentability of "combination" inventions differently in law from the patentability of some other type of invention undescribed and undefined.

The opinion below considered the "differences * * * and the result," in compliance with the statutory requirement that "the subject matter as a whole" be considered, 35 U.S.C. § 103, and with the same requirement in *John Deere* for determination of "the obviousness or nonobviousness of the subject matter." Thus was avoided the error of determining only whether the particular differences would themselves have been obvious or nonobvious.

23. The opinion below includes the statement that there was "no evidence on which a finding of non-obviousness could be based". (410 F.Supp. at 596, 193 USPQ at 448). The better statement would have been that there was "no evidence sufficient to rebut that offered by Peterson in support of a legal conclusion of obviousness." Absent facts established by him who has the burden of proving obviousness, 35 U.S.C. § 282, evidence on which to base a legal conclusion of nonobviousness is unnecessary.

24. Pointing to claim 4, Nickola says mounting the gas meter below the electric meter shortens the gas inlet exposure above the ground. There was no evidence of what specific events cause dangers. In any event, it would have been obvious that a short pipe provides less exposure than a long pipe. The district court correctly recognized that the low mounting feature is incapable in this case of satisfying the requirement for nonobviousness.

The district court correctly found the evidence of long-felt need insufficient. As Nickola testified, she made her invention immediately after "gas was newly introduced," and there was no evidence that others had even tried to fill a need for a post-electric meter-gas meter combination.

The district court correctly found the commercial success evidence also insufficient in this case. That determination was based on the view that: "The commercial success of the product is accounted for by plaintiff's patent monopoly [25] and the introduction of underground wires and piped natural gas to mobile home parks." (410 F.Supp. at 596, 193 USPQ at 448.) Absent demand for a product, however, there can be no commercial success. No patent can itself create market demand. A patent on the unwanted is worthless. The advent of piped gas was equally irrelevant as a cause for commercial success, because, as the testimony showed, the gas could have been and was piped to a central rack on which gas meters were mounted. To the extent that the court had in mind Nickola's early start with her product, promptly after gas was available to mobile parks, as the cause for her sales, the statement would apply to the evidence, but neither the existence (or non-existence) of the patent, nor the mere availability of gas, could account for purchasers' decisions to buy Nickola's product.

The primary reason for failure of the commercial success evidence in this case is its inadequacy. That evidence consists entirely of Nickola's statement that "40 to 50 thousand" units had been sold over a period of seven or eight years. An average of only 6,000 to 7,000 sales annually would not constitute a "rush to the invention" probative of nonobviousness. There was no evidence that a fortune had been waiting in the wings for him who first made the invention available to the public. It is that waiting fortune which implies that if the invention had been obvious it would surely have been earlier made. Further, there was no evidence of total demand, the extent to which that demand was met by the patented product, the extent to which the market abandoned earlier products in favor of the product patented, the extent to which advertising contributed or did not contribute to sales, and the like. In short, Nickola's commercial success evidence did not rise to the level of an indicium of nonobviousness listed as potentially relevant in *Graham* v.

25. The reference to a "patent monopoly" is not uncommon. Others, particularly those charged with infringement, have long employed the phrase pejoratively. But a valid patent never confers a monopoly in the traditional, historical, anticompetitive sense, as was explained by the Supreme Court in *United States* v. *Dubilier Condenser Corp.*, 289 U.S. 178, 186, 53 S.Ct. 554, 557, 77 L.Ed. 1114 (1933):

> "Though often so characterized, a patent is not, accurately speaking, a monopoly, for it is not created by the executive authority at the expense and to the prejudice of all the community except the grantee of the patent. *Seymour* v. *Osborne*, 11 Wall. 516, 533, 20 L.Ed. 33. The term monopoly connotes the giving of an exclusive privilege for buying, selling, working or using a thing which the public freely enjoyed prior to the grant. Thus a monopoly takes something from the people. An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of value to the community by adding to the sum of human knowledge. * * * He may keep his invention secret and reap its fruits indefinitely. In consideration of its disclosure and the consequent benefit to the community, the patent is granted." [Footnote and citations omitted.]

Like any property, a patent may be used in a plan to achieve a monopoly violative of our antitrust laws. But proof of that fact is required. *See Walker Process Equip., Inc.* v. *Food Mach. & Chem. Corp.*, 382 U.S. 172, 177-78, 86 S.Ct. 347, 15 L.Ed.2d 274 (1965). A patented product rarely enjoys a dominant share in the relevant market. As noted in *Northern Pac. Ry.* v. *United States*, 356 U.S. 1, 10 n. 8, 78 S.Ct. 514, 520, 2 L.Ed.2d 545 (1958):

> "Of course it is common knowledge that a patent does not always confer a monopoly over a particular commodity. Often the patent is limited to a unique form or improvement of the product and the economic power resulting from the patent privileges is slight." Congress has provided that patents "shall have the attributes of personal property." 35 U.S.C. § 261. The patent right, solely that of excluding others, is the fundamental element of all human rights called "property." The statutory, and therefore proper, characterization is not "patent monopoly," but "patent property."

John Deere, *supra*, 383 U.S. at 18,[26] 86 S.Ct. 684.

Conclusion

We concur in the district court's holding that the inventions recited in claims 4 and 21 would have been obvious at the time the inventions were made to a person having ordinary skill in the art, and that the claims were therefore invalid under 35 U.S.C. § 103. We concur also in the district court's implicit holding that the jury could not reasonably have found facts sufficient to support a legal conclusion that claims 4 and 21 are valid. Accordingly, we *affirm* the district court's grant of Peterson's motion for judgment notwithstanding the verdict.

AFFIRMED.

UNITED STATES of America, Appellee,

v.

Robert Anthony JENNEWEIN, Appellant.

No. 78-5076.

United States Court of Appeals, Sixth Circuit.

Argued July 5, 1978.

Decided Aug. 10, 1978.

Defendant was convicted in United States District Court for the Western District of Kentucky at Louisville, Oren R. Lewis, J., of theft from interstate shipment, and he appealed. The Court of Appeals held that though inference of guilty knowledge may be drawn from the fact of unexplained possession of recently stolen goods, additional inference that would permit finder of fact to conclude that the possessor of stolen property by virtue of such possession may be deemed to have participated in its theft is not justified.

Vacated and remanded.

Larceny ⇐64(1)

Though inference of guilty knowledge may be drawn from the fact of unexplained possession of recently stolen goods, additional inference that would permit finder of fact to conclude that the possessor of stolen property by virtue of such possession may be deemed to have participated in its theft is not justified.

Anthony H. Ambrose, Louisville, Ky., for appellant.

Albert Jones, U. S. Atty., James H. Barr, Asst. U. S. Atty., Louisville, Ky., Mikell Grafton, Prospect, Ky., for appellee.

Before PHILLIPS, Chief Judge, LIVELY, Circuit Judge, and PECK, Senior Circuit Judge.

PER CURIAM.

This appeal, perfected from the defendant-appellant's conviction pursuant to jury

26. The opinion below, in the midst of its novelty discussion, states: "The Court went on to state that commercial success, without invention, will not make patentability." (410 F.Supp. at 594, 193 USPQ at 446, citing cases.) The statement must necessarily mean only that commercial success *not due to the merits of an invention* cannot be an indicium of nonobviousness. The statement cannot be taken literally without attributing circuitous reasoning to the Court. The Court in *John Deere* recognized that commercial success could serve as evidence of nonobviousness and thus of patentability. At the time the statement first appeared (1950), courts equated "invention" to patentability, see note 20, *supra*. Taken literally, therefore, the statement would read "evidence of patentability (commercial success) without patentability (invention) will not make patentability." The statement has led on occasion to a total disregard of the evidence of nonobviousness represented by commercial success. If an invention is entirely lacking in novelty, no amount of commercial success can serve as evidence of its patentability. When the issue is obviousness-nonobviousness, however, a determination that an invention would have been obvious should be made, as should the determination of any issue in any type of case, only after consideration of *all* relevant evidence, see note 21, *supra*.

Q What were you told to think about?
A A center pedestal seat.
Q Just a center pedestal seat?
A Yes.
Q What were the objectives of designing a center pedestal seat?

What were you trying to get out of that?

What were you trying to accomplish?

A I haven't the faintest.

I wasn't trying to accomplish anything. I was asked to do it.

Q Just locating it in the center?
A Basically all I was told to think about was locating a support in the center of the seat, basically. That is all I was told, asked to do.
Q Who asked you to do that?
A Mr. Owen, Brooks -- I have forgotten one of them.

This was in, sometime around the first part of the year, February, March or something. I have forgotten when it was.

Q Was that 1972?
A '70 it was, by golly. I started playing around because -- I mean, they wanted to know if it could be done and I don't make answers on something that serious.

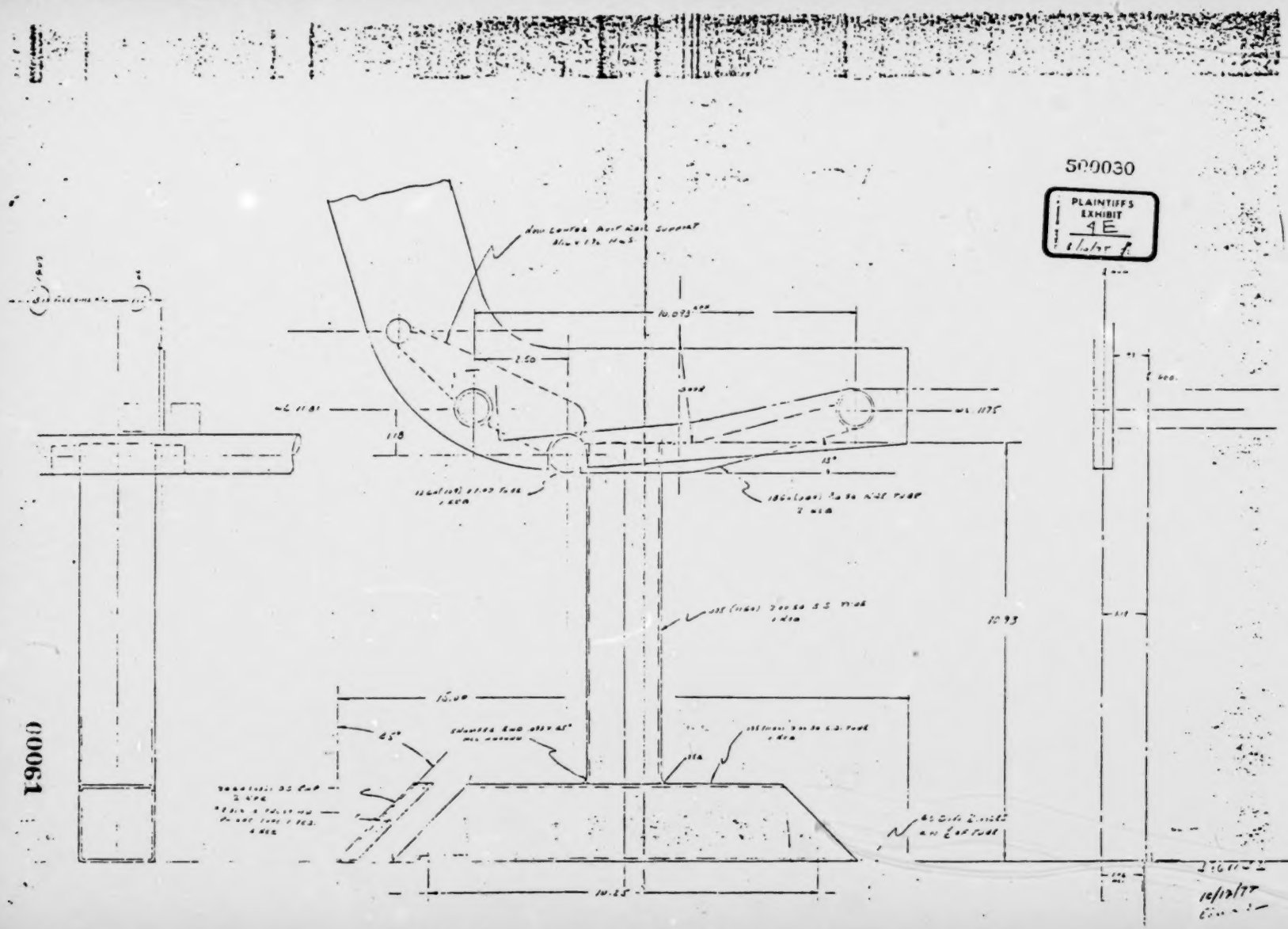
A He has the ability to design, develop and stress on paper and then it is usually group meetings to approve or disapprove what he has developed, as far as the seat is concerned.
Q Does his opinion carry some weight in terms of --
A Yes. It is all subject to Hughie Owen's approval, who is his boss.

They never reach a point without being tested before they get to consideration.

Q Plaintiff asked in interrogatory number 15, when was the decision first made to introduce a National inverted "T" pedestal seat.

Were you asked to contribute to the answer to that interrogatory?

A If I remember --
Q I mean contribute information.
A Not information, but I recommended that, because of the inquiries we have had from the field and the O.E.M.'s, and customers to start moving on the project. This was a couple of months in advance or beyond -- it was getting to be a hot and heavy subject.
Q You felt the definite pressure to come up with a center pedestal, I take it?
A Yes.



19000

A I think he is with Regal Manufacturing Company.
Q Have you read the Barecki Patent which is involved in this present suit?
A I have gone through it, yes.
Q Do you have any problems in understanding the structure of that?
A I understand what he has got, basically.

I don't understand all his claims for it, but I understand the structure.

Q Would you describe what that structure is?

MR. LYON: Objection. The document speaks for itself.

If you are going to ask him to describe what the patent shows, let's show him a copy of the patent. There is no reason to speak abstractly about it. It speaks for itself. It is a waste of time.

Q You don't have any trouble understanding it?
A I understand the claim.

The only thing I don't understand is how he got his claim.

Q But you don't have any troubles with the description and what it is?
A No.
Q Do you think you could make a seat like that from

that description?
A I don't see why not. Anybody could, with any background, engineering background could.

MR. BENEVELD: I don't have any more questions.

MR. LYON: Okay. Let's take a couple of minutes then.

(Recess had)

EXAMINATION OF ROBERT EDWARDS

BY MR. LYON:

Q Prior to 1951, when you left Karpen, did Karpen ever make a seat for railroad cars that had a pedestal located intermediate to the wall and aisle?
A Yes; the Pennsylvania Railroad.
Q What was the specific construction of that seat?
A That was a casting that was in the floor of the car, mounted on the floor of the car, revolving chair.

The end structure was different but the framework was basically the same.

Q That seat was actually used on railroad cars?
A Used on the Pennsylvania Railroad.
Q And the pedestal itself was in a center position with respect to the overall seat?